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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1947.

No. 162

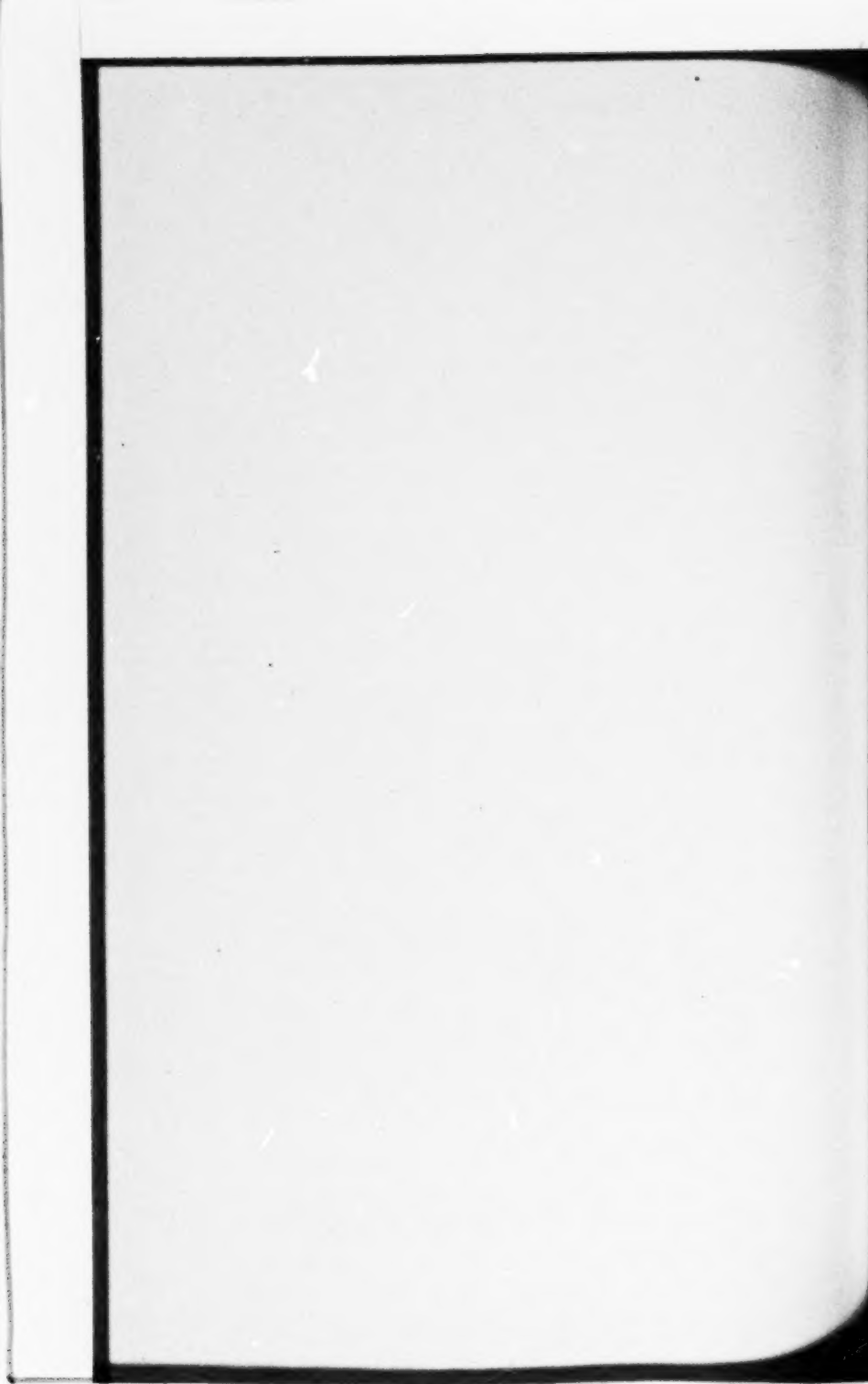
EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*

*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SIXTH CIRCUIT.**

✓  
MAX W. ZABEL,  
FOSTER YORK,  
*Counsel for Petitioner.*



## INDEX.

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	PAGE
Petition for Writ of Certiorari to the United States	
Circuit Court of Appeals for the Sixth Circuit . . . .	1-7
Summary Statement of Matter Involved . . . . .	1
Questions Involved . . . . .	4, 5
Reasons for Granting the Writ . . . . .	5, 6
Brief in Support of Petition . . . . .	8-25
Jurisdiction . . . . .	8
Statement . . . . .	8
Specification of Errors . . . . .	11
Argument . . . . .	14
I. The Circuit Court of Appeals for the Sixth Circuit, in Sustaining the Validity of the Patent in Suit Departed From the Principles of <i>Morgan vs. Daniels</i> , 153 U. S. 120 . . . . .	14
II. The Circuit Court of Appeals for the Sixth Circuit, in Affirming the Judgment of the District Court in Rejecting the Evidence as to Interferences 75,056, 75,057 and 75,058 Departed From the Principles of <i>Sinclair vs. Interchemical Company</i> , 325 U. S. 327, 330 . . . . .	17
III. The Circuit Court of Appeals for the Sixth Circuit, in Arriving at Its Conclusion That It Would Not Follow the Findings of the Court of Customs and Patent Appeals, Reported in 141 F. 2d 816, Based Its Ruling on an Erroneous Assumption of Fact, Which Error is Visually Demonstrable by an Examination of Two Small Exhibits Before This Court . . . . .	17

- IV. The Mayo Patent is Invalid Because the Court of Appeals Held Invalid Claim 6 Which the Court of Customs and Patent Appeals Had Previously Indicated Was Invalid. Under the Doctrine of Triplett, et al. *vs.* Lowell, et al., 297 U. S. 638, 646, Mayo's Failure to Disclaim Claim 6 Renders the Entire Mayo Patent Invalid ..... 20
- V. Opinion of the Circuit Court of Appeals for the Sixth Circuit Runs Counter to the Doctrine of Halliburton *vs.* Walker, 329 U. S. 1 22

#### CASES CITED.

Ensten v. Simon Ascher & Co., 282 U. S. 445, 453....	4
Halliburton v. Walker, 329 U. S. 1, 91 L. Ed. 15	
.....3, 4, 5, 6, 12, 23, 25	
Maytag Co. v. Hurley Machine Co., 307 U. S. 243....	4, 21
Morgan v. Daniels, 153 U. S. 120, 38 L. Ed. 657	
.....3, 4, 5, 6, 11, 12, 14, 20, 21	
Radio Condenser Co. v. General Instrument Corp., 65	
F. (2nd) 458, 459.....	4, 21
Radio v. Radio, 293 U. S. 1.....	11, 12
Refrigerator Patents Corp. v. Stewart-Warner, 159	
F. (2nd) 972.....	3, 6, 12, 22, 24
Sinclair v. Interchemical, 325 U. S. 327, 330.....	17
Sinko Tool and Mfg. Co. v. Automatic Devices Corp.,	
157 F. (2nd) 974.....	9
Sperry v. Aufiero et al., 134 F. (2nd) 174, 179 (5)...	3, 9, 14
Sperry v. Payne, Sperry v. Teschner, 141 F. (2nd)	
816, 821, 822, 827.....	2, 3, 10, 15, 20, 24
Triplett et al. v. Lowell et al., 297 U. S. 638, 646.....	
.....	4, 5, 6, 12, 21



STATUTES CITED.

Judicial Code (Federal Declaratory Judgment Act)	
Sec. 274(d).....	2
U. S. C. Tit. 28, Sec. 347, Sec. 240(a) Judicial Code....	8
U. S. C. Tit. 28, Sec. 400, Judicial Code Sec. 274(d)...	8
U. S. C. Tit. 28, Sec. 41(7), c. 231 Sec. 24, par. 7, Stat. 1902 .....	8

OPINION OF THE COURT BELOW.

The Opinion of the Circuit Court of Appeals for the Sixth Circuit is officially reported in *Excel v. Bishop and Babcock Mfg. Co.*, 167 F. (2nd) 962.

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**No.** \_\_\_\_\_  
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**EXCEL AUTO RADIATOR COMPANY,**  
*Petitioner,*  
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**THE BISHOP AND BABCOCK MANUFACTURING  
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**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SIXTH CIRCUIT.**  
\_\_\_\_\_

*To the Honorable Frederick N. Vinson, Chief Justice of the  
United States, and the Associate Justices of the Supreme  
Court of the United States:*

Your petitioner respectfully shows:

**Summary Statement of Matter Involved.**

Petitioner (plaintiff below) seeks a review of a judgment of the United States Circuit Court of Appeals for the Sixth Circuit rendered May 3, 1948 (R. 458), rehearing denied June 2, 1948 (R. 477). That judgment affirmed a judg-

ment (R. 438) of the District Court of the United States for the Northern District of Ohio, Eastern Division, holding all 13 claims of *Mayo* patent No. 2,322,041 (R. 135) valid, and all claims excepting claim 11, infringed,—with this exception that the Circuit Court of Appeals held claim 6 invalid.

This action was initiated Sept. 21, 1945 by petitioner upon filing its complaint under Sec. 274d, Judicial Code (Federal Declaratory Judgment Act) for a declaratory judgment to have said patent declared invalid.

The Court will find (please see the brief) that this cause is quite analogous to one in which two Courts of last resort have differed.

The device involved is one used in the great majority of automobiles and is called a heater, in which there is provision for two streams of heated air, one to heat the car, and the other to aid in windshield defrosting. It is two separate and distinct devices driven by one motor but mounted in *one* framework.

The patent in suit was clearly indicated as invalid in a decision by the Court of Customs and Patent Appeals in February 1944 (*Sperry v. Payne*, *Sperry v. Teschner*, 141 F. (2nd) 816), based upon the existence and successful testing in the year 1935 of certain devices constructed by petitioner and now before this Court (Petitioner's Exhibits 1 to 6 incl.).

The existence and successful testing of these devices in 1935 *antedates* the earliest invention date (R. 62) *claimed* by Mayo (Mayo claimed Feb. 1936, Ex. N, p. 14).

The decision as to which review is sought revitalizes this patent and enjoins petitioner from making the devices made by it since 1935, that is, the very devices now before this Court, whose *existence* in 1935 has been found by six tribunals,—twice by the Patent Office Interference Examiner,

both decisions (R. 328, 330; R. 353, lines 1 to 7; R. 355, 358), twice by the Patent Office Board of Appeals, both decisions (R. 344; R. 365), and twice by the Court of Customs and Patent Appeals, both decisions, *Sperry v. Aufiero, et al.*, 134 Fed. (2nd) 174, 179; *Sperry v. Payne, Sperry v. Teschner*, 141 (2nd) 816, 821, 822. These same 1935 devices now before the Court are fully and completely operative to perform their functions. The Court of Customs and Patent Appeals in 141 Fed. (2nd) 816, 822 and 827, held that they were successfully tested in 1935. See also R. 460.

The decision of the Circuit Court of Appeals overruling the Court of Customs and Patent Appeals is in direct conflict with the doctrine of *Morgan v. Daniels*, 153 U. S. 120, 38 L. Ed. 657. The District Court refused to consider the Patent Office Interference record on which the six decisions establishing the existence of the devices is based (R. 432). The Court of Appeals upheld such ruling by the District Court on the ground that Mayo was not bound by such prior use testimony, and refused to follow the findings of the Court of Customs and Patent Appeals because of what it believed was controlling new evidence, and based its decision on an entirely erroneous (visually demonstrable) assumption of fact which the Court mistakenly believed followed from the new evidence. The erroneously assumed fact was never asserted by respondent and when the error was called to the attention of the Court by petition on rehearing, respondent made no effort to justify the Court's erroneous finding. The petition was summarily dismissed.

The decision runs counter to *Halliburton v. Walker*, 329 U. S. 1, 91 L. Ed. 15. The interpretation of that decision by the Court of Appeals of the Sixth Circuit is clearly erroneous, and is contrary to the interpretation given by other circuits. See particularly *Refrigerator Patents Corp. v. Stewart-Warner*, 159 Fed. (2nd) 972.

The second decision by the Court of Customs and Patent Appeals finding invention by Sperry prior to Mayo's earliest claimed date was such notice as required Mayo either to disclaim or else test the issue in another proceeding following that decision. Mayo chose to test the issue by filing a counterclaim in the instant suit. Claim 6 was held invalid by the Court of Appeals. Under the doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 643, the entire patent is invalid. See also, *Radio Condenser Co. v. General Instrument*, 65 F. 2d 459; *Ensten v. Simon Ascher & Co.*, 282 U. S. 445; *Maytag Co. v. Hurley Machine Co.*, 307 U. S. 243.

The device of the patent in suit and petitioner's device operate upon entirely different principles and are not capable of being comprehended by one patent.

The patent merely combines in one framework two prior art devices which accomplish the same functions.

The patent covers such devices broadly, and as its use is confined to the automobile trade which is concentrated in the Sixth Circuit, no other litigation is foreseeable.

### Questions Involved.

1. Is it proper for a Circuit Court of Appeals to overrule a decision by the Court of Customs and Patent Appeals indicating patent invalidity when the only basis for its ruling is an erroneous assumption of fact, the error of which is not denied by respondent, and which error is visually demonstrable by examination of two small exhibits before this Court? *Morgan v. Daniels*, 153 U. S. 120. The District Court made no like finding of fact and even the respondent did not at any time assert the existence of such erroneously assumed fact. Four Patent Office Tribunals and the Court of Customs and Patent Appeals differ with the Court of Appeals for the Sixth Circuit. Petition for

Rehearing was denied *without comment* even though respondent's reply to Petitioner's Petition for Rehearing did *not* deny but instead *accepted* Petitioner's contention that the Court had made an erroneous assumption.

2. Is it proper to hold infringement of a patent by a device operating upon an entirely different principle, *Halliburton v. Walker*, 329 U. S. 1, simply because the patent contains "means" claims which can be made to read on the device?

3. Is the aggregation of two prior art devices (automobile heaters) into one framework and driving them by one motor instead of two, a patentable invention?

4. Is it proper for a Circuit Court of Appeals to fail to hold a patent invalid in its entirety after it has held invalid one claim which assignee of patent failed to disclaim after assignee had been given notice of invalidity of all claims by a previous decision of the Court of Customs and Patent Appeals? *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

### Reasons for Granting the Writ.

1. The four Patent Office decisions and the two decisions of the Court of Customs and Patent Appeals being in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit constitutes a situation analogous to that in which two Circuit Courts of Appeals differ, *Morgan v. Daniels, supra*. Especially is this true where the basis for overruling the Court of Customs and Patents Appeals is a visually determinable error of fact *assumed* by the Appellate Court, unsupported by any findings by the District Court and neither urged by Respondent at any time nor defended in its reply to our petition for rehearing which was summarily denied. The point is one which has therefore never been argued. This single point on which the decision of the Court of Appeals overruling the Court of

Customs and Patent Appeals was based is the statement by the Court that the fan blower element of Exhibit 1, which was part of the 1935 Sperry development, was identical with a fan blower element made by "Midwest" which was not made until 1936. A mere *visual* inspection of the blower element made by Midwest and said Exhibit 1 is sufficient to dispel such fallacy. Both are before this Court.

2. The District Court and the Circuit Court of Appeals failed to give effect to the Patent Office Interference decisions and thus violate the dictates of *Morgan v. Daniels*, 153 U. S. 120.

3. The decision revitalizes a patent whose invalidity was indicated years ago and which invalidity was confirmed by the Court of Appeals as to one claim; and thus the decision violates the disclaimer doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

4. As automobile heaters are installed almost exclusively in the Sixth Circuit no other litigation involving the patent is foreseeable.

5. The decision is in conflict with the doctrine of *Halliburton v. Walker Corp.* as the device held to infringe operates upon a new and entirely different principle from that of the patent in suit. The interpretation of *Halliburton v. Walker* decision by the Court of Appeals for the Sixth Circuit nullifies the decision by the Supreme Court in the Sixth Circuit and is contrary to the interpretation in other circuits, particularly the Seventh Circuit. See *Refrigerator Patents Inc. v. Stewart Warner*, 159 Fed<sup>2d</sup> 972.

6. The devices in question are standard articles of trade and the patent in suit would blanket them until 1960.

Wherefore, Petitioner prays that a Writ of Certiorari issue under the seal of this Court directed to the United States Circuit Court of Appeals for the Sixth Circuit, sit-



ting at Cincinnati, Ohio, commanding said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record, and all proceedings of the said Circuit Court of Appeals had in the case numbered and entitled on its docket No. 10,548, *Excel Auto Radiator Company, Appellant v. The Bishop and Babcock Manufacturing Company, Appellee*, to the end that this cause may be reviewed and determined by this Court; that the judgment therein of the said Circuit Court of Appeals be reversed by this Court; and that the cause be remanded to that Court with directions to hold the patent in suit invalid, and such other and further relief as this Court may deem proper.

MAX W. ZABEL,

FOSTER YORK,

*Counsel for Petitioner.*

## **BRIEF IN SUPPORT OF PETITION.**

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### **Jurisdiction.**

Petitioner would invoke the jurisdiction of this Court under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, U. S. C. Title 28, Sec. 347, to review a judgment of the United States Circuit Court of Appeals for the Sixth Circuit dated May 3, 1948 (R. 458), in a suit based upon the Declaratory Judgment Act, U. S. C. Title 28, Sec. 400, Judicial Code, Sec. 274(d), alleging jurisdiction under the Act of March 3, 1911, c. 231, Sec. 24, par. 7, Stat. 1902, U. S. C. Title 28, Sec. 41(7), and in which a counterclaim was filed charging infringement of United States Letters Patent. Petition for rehearing was denied June 2, 1948 (R. 477). This petition is presented within three months from and after the denial of petition for rehearing.

### **Statement.**

A short historical statement may here be desirable. Mayo (inventor of the patent in suit) filed his patent application March 28, 1936. Petitioner's employee and assignor (Sperry) filed his patent application (for a device operating upon a novel and entirely different principle) on March 20, 1937. Patent Office interference proceedings were instituted between these two and seven other patent applicants.

The Patent Office Interference Examiner held (R. 328, lines 12 et seq.) that the devices now before this Court had been in existence "in co-operative relation at least by the end of October, 1935", and then proceeded to declare

Mayo (whose earliest date was February, 1936) as the first inventor on the extremely technical ground that (R. 339, ninth line from the bottom) Sperry's testimony had not shown *sufficient* testing, although the said devices in the same form constituted Sperry's *commercial* device.

The Patent Office Board of Appeals (R. 345) affirmed, so that we have a second tribunal holding the existence of the Sperry devices in 1935.

On appeal to the Court of Customs and Patent Appeals that Court affirmed on the same technical ground of insufficient testing (*Sperry v. Aufiero, et al.*, 134 F. (2nd) 174, 179 (5)).

Three tribunals have thus far held that the devices before this Court were in existence in 1935, but relied upon the technical Patent Office ground of insufficient testing. The Courts in general do not favor the same degree of strictness. *Sinko Tool and Mfg. Co. v. Automatic Devices Corp.*, 157 Fed. (2nd) 974.

In the course of the above proceedings, on or about February, 1937 (about eleven months after the filing of the Sperry patent application), *Payne* filed a patent application on a device operating upon the *Sperry* principle. That patent application was *under the control of Respondent*. Patent Office interference proceedings were instituted between the *same* Sperry patent application (involved in the Mayo interference), the *Payne* patent application, and several other applicants.

Sperry relied upon the *same* devices in this second interference proceeding but further elaborated his evidence as to testing. The Patent Office Interference Examiner again held that the devices were in existence in 1935 (R. 353 line 1). He then said that they were *probably* tested (R. 353, line 16 from bottom) but, not sufficiently.

The Board of Appeals again affirmed such decision.

On appeal to the Court of Customs and Patent Appeals (*Sperry v. Payne*, *Sperry v. Teschner*, 141 F. (2nd) 816) the additional Sperry evidence with regard to testing was held sufficient and Sperry prevailed as to his specific device. Since *all* evidence by Sperry related to these 1935 devices, such decision by the Court is in effect a reversal of its previous opinion. *The Circuit Court of Appeals in referring to this decision by the Court of Customs and Patent Appeals says: "but the Court of Customs and Patent Appeals reversed these decisions (141 Fed. (2nd) 816), holding that the evidence established Sperry's reduction to practice in 1935 by adequate testing of his models, and awarded priority to Sperry"* (R. 460). The opinion of the Circuit Court of Appeals in regard to this ruling of the Court of Customs and Patent Appeals states: "It would however be persuasive if relevant and if based on the same evidence as that presented here" (R. 460, lines 28 thru 30). The Court (R. 460, last three lines) further says, "Also though we gave careful consideration to the findings of fact of this expert court, we have before us testimony, not previously introduced which, if it had been before the patent tribunals, might have changed the decision of the Court of Customs and Patent Appeals in the last case (141 Fed. (2nd) 816)." The testimony referred to by the Court is testimony on which the Court made an error of fact which is apparent by visual examination of two exhibits: Ex. 1 and Ex. NN. This was called to the Court's attention on Petition for Rehearing; it was not denied by respondent in its reply. The Court denied the Petition for Rehearing without comment.

That this erroneously *assumed* fact had a determining character upon the judgment of the Circuit Court of Appeals, is evident from the statement (R. 460, lines 16

and 17) that "this question has a fundamental bearing on the outcome of the case".

The Court of Appeals justifies its exclusion of the prior inventorship evidence on the ground that *Mayo* is not bound by it because not a party to the second interference proceeding, even though respondent was in control of both Mayo and Payne patent applications.

*Morgan v. Daniels*, however, applies when the assignee is the same even though one of the inventors (*Mayo*) was not a party in the final interference. *Radio v. Radio*, 293 U. S. 1.

The Mayo patent having issued, the Court of Customs and Patent Appeals could take no action with regard to it, and unless this Court grants Certiorari it will for over a decade blanket the industry. Petitioner is not here asking for a ruling that the patent be granted in behalf of Sperry, as such action is foreclosed by the first decision of the Court of Customs and Patent Appeals.

Petitioner's only recourse to continue making what it had made since prior to Mayo's date was the petition for declaratory judgment.

### Specification of Errors.

1. The Circuit Court of Appeals erred in overruling the Court of Customs and Patent Appeals by not following the well-established doctrine of *Morgan v. Daniels*, 153 U. S. 120.

2. The Circuit Court of Appeals erred in affirming the District Court in excluding the stipulated records in the group of interferences won by petitioner, on the ground that the evidence showing invalidity of the patent in a companion interference (under the control of Respondent) to which Mayo however was not a party, "does not bind this

Court, since Mayo was not a party to those proceedings". The fact that Mayo was not a party does not make the evidence irrelevant nor take this case out of the ruling of *Morgan v. Daniels*, *Radio v. Radio*, *supra*.

3. The Court erred in applying the rule that the burden was upon Petitioner to show that the Mayo patent was not invalid, whereas, if *Morgan v. Daniels* had been applied, as it should have been, the burden would have been the opposite. The "new evidence" (R. 460, last line; 461, first line) does not satisfy the "thorough conviction rule" which the Court applied contrary to its correct application (R. 461, lines 4-7).

4. The Circuit Court of Appeals based its decision overruling the Court of Customs and Patent Appeals on an erroneous *assumption* of a *fact* not urged by Respondent, as to which there had been no finding by the District Court, never argued, not supported by Respondent in its reply to Petitioner's petition for rehearing, not clarified by the Court in its summary denial of the petition, and as to which six tribunals (four in the Patent Office and twice by the Court of Customs and Patent Appeals) have held the contrary. The error of the Court's assumption is obvious by a mere *visual* inspection of two small simple elements which are before this Court as exhibits.

5. The Circuit Court of Appeals erred in not applying the doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646, relating to disclaimers.

6. The Circuit Court of Appeals erred in not following the doctrine of *Halliburton v. Walker*, 329 U. S. 1, and in its interpretation thereof differing from the interpretation placed on said doctrine by the Circuit Court of Appeals for the Seventh Circuit in *Refrigeration Patents Corp. v. Stewart-Warner*, 159 F. (2nd) 972.

7. The Circuit Court of Appeals erred in holding Mayo

patent No. 2,322,041 valid and thus revitalizing said patent, whose invalidity had been indicated several years before.

8. The Circuit Court of Appeals erred in holding the Mayo patent No. 2,322,041 infringed by the complained-of Sperry heater.

9. The Circuit Court of Appeals erred in affirming the Judgment of the District Court.



## ARGUMENT.

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### **I. The Circuit Court of Appeals for the Sixth Circuit, in Sustaining the Validity of the Patent in Suit Departed from the Principles of *Morgan v. Daniels*, 153 U. S. 120.**

The reasons why we respectfully contend that this case comes under the doctrine of *Morgan v. Daniels*, 153 U. S. 120 and is parallel to one in which two Circuit Courts of Appeals have differed are the following: Petitioner's employee, Sperry (since deceased) constructed various embodiments of the device in suit in (as held by four Patent Office Tribunals and twice by the Court of Customs and Patent Appeals) the year 1935. The earliest date to which Mayo (inventor of the patent in suit) could and did lay claim is February 1936 (R. 62, Ex. N, p. 14). Mayo filed his patent application March 28, 1936, and Sperry filed his on March 20, 1937. The two patent applications being co-pending the Patent Office declared interference proceedings between said Mayo, said Sperry and seven other co-pending applications, to determine the question of priority of invention.

Upon final hearing and after the taking of testimony by all parties the Patent Office Interference Examiner held (R. 328, 330) that the Sperry devices now before this Court had been in existence since October 1935, prior to Mayo's earliest date of February 1936, but awarded priority to Mayo over Sperry on the technical ground that the devices had been insufficiently tested (R. 328, 330), despite the fact that those same devices constituted Petitioner's commercial product and are now as then in operable condition.

The Patent Office Board of Appeals affirmed the decision (R. 343), and so did the Court of Customs and Patent Appeals (*Sperry v. Aufiero, et al.*, 134 F. 2d 174). The pat-



ent in suit thereupon issued to Mayo, thus settling the controversy in so far as it concerned who as between *Mayo and Sperry* obtained a patent on the broad claims in issue. Sperry's assignor is therefore here not asking for a patent in its own behalf.

The important thing however is the fact that *so far* three technically informed tribunals have held the Sperry devices to have been in existence in 1935.

The said Sperry patent application disclosed a device which, although performing the same functions as the Mayo device, operated upon an entirely different and novel principle not disclosed in the Mayo patent application.

During the course of the above proceedings, Payne, and also Teschner filed patent applications on a device following Sperry's principle, and the *said Sperry application* became involved in a second interference proceeding initiated by the Patent Office. The interference proceedings in behalf of Payne and also Teschner were under the control of Respondent (R. 29, 34).

During this second proceeding further testimony was added in behalf of Sperry to further elaborate his tests of the 1935 devices, but the Patent Office Interference Examiner again held that although the devices were in existence in 1935, the tests were insufficient and awarded priority to Payne (R. 362, and on other counts to Teschner, R. 380). The Patent Office Board of Appeals affirmed (R. 366, 372, 385).

Upon appeal to the Court of Customs and Patent Appeals said Court reversed the Patent Office ruling (*Sperry v. Payne, Sperry v. Teschner*, 141 F. (2nd) 816) and ruled that these 1935 Sperry devices *had* been sufficiently tested. That the Court of Customs and Patent Appeals so held is conceded by the Circuit Court of Appeals in its opinion (R. 460, lines 3 to 8) saying "*but the Court of Customs and Patent Appeals reversed these decisions (141 F. (2nd) 816), holding that the evidence established Sperry's reduction to*

*practice in 1935 by adequate testing of his models, and awarded priority to Sperry.*" Yet it is in respect to this very testimony of the second interference proceeding that the Court of Appeals affirmed the District Court in excluding it on the ground of irrelevancy and immateriality.

There were thus three additional rulings to the effect that the Sperry devices before this Court were in existence in 1935, making six decisions in all.

This later decision by the Court of Customs and Patent Appeals thus nullified its prior decision in the Sperry-Mayo interference by holding that Sperry's invention date in reality was in 1935, and hence prior to Mayo's earliest alleged date of February 1936. It established prior invention by Sperry and thus clearly indicated invalidity of the Mayo patent which had in the meantime issued.

We respectfully submit that the six decisions by technically qualified tribunals, being in conflict with the decision of the Circuit Court of Appeals, constitutes a case parallel to one in which two Circuit Courts of Appeals have differed upon the question of patent validity. Thus where the Court of Appeals refuses to apply *Morgan v. Daniels* its decision is subject to review by the Supreme Court.

And also more particularly is this true when the Circuit Court of Appeals bases its finding (R. 463, lines 3 and 4 from bottom of page) that "Sperry did not prove conception earlier than the fall of 1936" upon an erroneously assumed fact, whose non-existence can be established by mere visual inspection of two small simple elements in evidence.

**II. The Circuit Court of Appeals for the Sixth Circuit, in Affirming the Judgment of the District Court in Rejecting the Evidence as to Interferences 75,056, 75,057 and 75,058 Departed from the Principles of *Sinclair v. Interchemical Company*, 325 U. S. 327, 330.**

The Court went far afield from *Sinclair v. Interchemical*, 325 U. S. 327, especially when we find the District Court (R. 438) holding as conclusion of law 4 that the second interference record is irrelevant and immaterial, and the Circuit Court of Appeals saying (R. 460): "We think the District Court did not err in rejecting the evidence as to interferences 75,056, 75,057, and 75,058," which were the second set of interference proceedings. That evidence is material on the question of validity. Refusal to consider records and decisions bearing on the validity of a patent is contrary to *Sinclair v. Interchemical*, 325 U. S. 327, 330, wherein it was held that where invalidity appeared the Court must so find.

**III. The Circuit Court of Appeals for the Sixth Circuit, in Arriving at Its Conclusion That It Would Not Follow the Findings of the Court of Customs and Patent Appeals, Reported in 141 F. 2nd. 815, Based Its Ruling on an Erroneous Assumption of Fact, Which Error Is Visually Demonstrable by an Examination of Two Small Exhibits Before This Court.**

That the Circuit Court based its ruling *solely* upon the before-mentioned *single erroneously assumed*, easily controvertible, alleged fact is clear from the following excerpts from the opinion:

"This evidence relates to the bakelite blower which was part of Sperry's Exhibit No. 1." (R. 461, lines 8 and 9.)

"Only one plastic mold was made for Midwest,

and this was the only one ever made by Weis." (R. 461, lines 32 and 33.)

"The first samples of the mold were made in July 1936." (R. 462, line 1.)

"Two bakelite wheels, made by Midwest, introduced in evidence, appear to be of material and structure *identical* with that of Sperry's Exhibit No. 1." (R. 462, lines 8 to 12.) (Emphasis ours.)

"We think the testimony of the three disinterested witnesses as to the manufacture of the blower mold and the blower wheels which were a part of Sperry's first experimental model, supported by the documentary evidence from three independent companies, proves that Sperry's story of reduction to practice in 1935 is a mistake." (R. 462, last paragraph.)

"They not only support the award of priority to Mayo over Sperry in 134 Fed. (2nd) 174, but they demonstrate from Sperry's own evidence that his conception, as well as his reduction to practice, was in 1936 instead of 1935." (R. 463, lines 13 to 16.)



"Since the first machine was actually made in the latter part of 1936, and since Sperry, so far as he dates his conception at all, places it in close time connection with the making of Exhibit No. 1, these facts militate strongly against the correctness of the second decision of the Court of Customs and Patent Appeals (141 Fed. (2nd) 816)." (R. 463, lines 22 thru 28.)

"Unquestionably the first device was made some time after September 1936. Sperry did not prove conception earlier than the fall of 1936." (R. 463, lines 1 to 5 from bottom of page.)

No other fact is used as a basis for the Court's ruling.

In other words, the Circuit Court of Appeals decides counter to the six tribunals on the assumption that the Midwest blower elements (available only in 1936) are *identical* to the blower element of Sperry Exhibit No. 1. They are far from identical. The blower element of Sperry Exhibit 1 *could not come out* of the Midwest mold as clearly apparent from the following:

**Comparison of Blowers of Exhibit 1, Exhibits NN  
and OO, and Exhibit M-28**

	Sperry Ex. 1 (1 Blower)	1935 Blower Mold Ex. M-28 (2 Blowers)	1936 Midwest Blower Ex. NN & OO (2 Blowers)
Maker's trade-mark on front face between a pair of blades.			No trade-mark at any place
Other markings be- tween blades	6 5890	4 5890	1 5890
Marking on center of rear face.	L.H. 22349	L.H. 22349	R.H. 22350
Thickness of blades	3/32"	3/32"	7/64"
Width of blade at base of cone	15/16"	15/16"	15/16"
Diameter of disk	3 3/4"	3 3/4"	3-9/16"
Thickness of disk	.140"	.140"	.125"
Number of blades	16	16	16
Length of blade	1 1/2" *	2 3/4"	2 1/4"

\* The evidence (Ex. 20, p. 138, XQ. 121) shows that the blades of the blower used in Exhibit 1 were originally longer. L.H. signifies left hand.

On the contrary, the blower element of Sperry Exhibit No. 1 came from a mold available at least as early as 1935 (Defendant's Ex. N, pp. 288, 312, 360).

Sperry Exhibit No. 1 was not relied upon to prove either conception or reduction to practice. It was intended merely to show in a preliminary experimental manner that there might be something to Sperry's novel idea of for the first time using the non-functioning central portion of a propeller fan. Substantially all of Sperry's testimony is directed to the full-size operative models now before this Court, Exhibits 3, 4, 5, 6 and 8.

As to the blower element of Sperry Ex. 1, Sperry testified as to where he believed (P. Ex. 20, pp. 51-52) the element may have come from. The new testimony in this

suit simply shows that Sperry may have been mistaken as to *where* the blower originated but not as to its date. The date is material, not the place, and it was on the date that the Court of Appeals went astray. The Court's error on this point is so clear that Respondent did not deny it.

We are thus confronted by a clean-cut contest with six decisions overruled by the decision of the Circuit Court of Appeals on the ground, (1) of a visually determinable error of fact and (2) that new evidence not before the Patent Office does not have to be sufficient to satisfy the requirement of *Morgan v. Daniels* in overcoming the effect of a ruling by the Court of Customs and Patent Appeals.

**IV. The Mayo Patent Is Invalid Because the Court of Appeals Held Invalid Claim 6 Which the Court of Customs and Patent Appeals Had Previously Indicated Was Invalid. Under the Doctrine of Triplett et al. v. Lowell et al., 297 U. S. 638, 646, Mayo's Failure to Disclaim Claim 6 Renders the Entire Mayo Patent Invalid.**

However, the Court of Appeals held claim 6 of the Mayo patent invalid. The Court of Customs and Patent Appeals in *Sperry v. Payne*, *Sperry v. Teschner*, 141 F. (2nd) 816, had previously indicated that claim 6 and all other claims in the Mayo patent were invalid as shown by its finding that Sperry had reduced his invention to practice prior to the earliest alleged invention date of Mayo in that suit or in the present suit. Respondent refused to accept the findings of the Court of Customs and Patent Appeals and did not disclaim any of the claims of his patent in suit. Respondent relinquished the privilege of disclaimer and by filing a counterclaim in the present suit proceeded to relitigate in the Court of Appeals of the Sixth Circuit the claims which it was under notice were invalid. Under the

doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646, Respondent filed this counterclaim at the risk of loss in the Court of Appeals in the Sixth Circuit of the other claims in the patent even though valid if the Court of Appeals of the Sixth Circuit would hold invalid any of the claims previously adjudicated. While the decision of the Court of Customs and Patent Appeals is not strictly an adjudication that claim 6, or any of the other claims of the Mayo patent, was invalid, the decision and the findings constitute notice that all the claims are invalid under the doctrine of *Radio Condenser Co. v. General Instrument Corporation*, 65 F. (2nd) 458, 459, and *Maytag Company v. Hurlley Machine Co.*, 307 U. S. 243.

The fact that the Court of Appeals held claim 6 invalid on different grounds than indicated by the Court of Customs and Patent Appeals in 141 F. (2nd) 816, does not remove this case from the disclaimer doctrine of *Triplett, et al. v. Lowell, et al.*, *supra*. In ruling out the evidence of the second interference on which the Court of Customs and Patent Appeals based its decision in 141 F. (2nd) 816, the Court of Appeals placed itself in a position where it could not hold the claims of the Mayo patent invalid for the same reasons given by the Court of Customs and Patent Appeals unless it applied the doctrine of *Morgan v. Daniels*, which it should have done but failed to do, as has been pointed out above.

The holding by the Court of Appeals that claim 6 is invalid renders all of the claims of the Mayo patent invalid under the doctrine of *Triplett v. Lowell*, *supra*.



**V. Opinion of the Circuit Court of Appeals for the Sixth Circuit Runs Counter to the Doctrine of *Halliburton v. Walker*, 329 U. S. 1.**

The Court of Appeals for the Sixth Circuit gives an interpretation of the *Halliburton case*, 329 U. S. 1, which is contrary to that of the Seventh Circuit in *Refrigerator Patents v. Stewart Warner*, 159 Fed. 972.

The situation in the present case is very similar to the situation in the above mentioned *Halliburton case* where the patentee was suing for an infringement on a combination having the term "means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing section to clearly distinguish the echoes of said couplings from each other." This term corresponds to the following terms used in the Mayo patent in suit:

Claim 12—"means for admitting air which has passed through said radiator to the central portion of said housing." Compare this term with the structural definition given in Claim 11 which reads "a conduit leading from a relatively small area of said radiator to the central portion of said housing for conducting heated air from the former to the latter." Because of this recited structure appellee withdrew Claim 11 from its charge of infringement.

Claim 10—"means for defining different air flow paths for said respective impellers." Compare this also with the admittedly non-infringed Claim 11.

Claims 8 and 9—"means for guiding air through the radiator in separate paths." This term is based on the wall 32 and the partition 65 of the Mayo patent, but appellee contends that it is broad enough to cover the patented arrangement of appellant's device whereby such wall and partition are completely eliminated.



Claim 5—"and means within said casing for propelling air through said radiator and said discharge openings into the body of the car, and simultaneously propelling a portion of the air which is passed through said radiator to another portion of said radiator and thence through said duct."

Claim 7—"means for heating air and for circulating it through the body of the car, \* \* \* and means for impelling air from said first named heater in contact with said auxiliary surface and through said duct into contact with the windshield."

In the *Halliburton Oil* case, *supra*, the Court refused to give the "means" clause any specific interpretation but simply held the claim invalid and *therefore not infringed*. In the Mayo patent likewise it is not seen how the "means" clauses can be given any specific construction, but such claims as Claims 5 to 10 and 12 must be held invalid as not complying with Revised Statute 4888. As the Supreme Court in *Halliburton v. Walker*, *supra*, stated (329 U. S. 13):

"Had Walker accurately described the machine he claims to have invented, he would have had no such broad rights to bar the use of all devices now or hereafter known which could accept waves. For had he accurately described the resonator together with the Lehr and Wyatt apparatus, and sued for infringement, charging the use of something else used in combination to accent the waves, the alleged infringer could have prevailed if the substituted device (1) performed a substantially different function; (2) was not known at the date of Walker's patent as a proper substitute for the resonator; or (3) had been actually invented after the date of the patent. *Fuller v. Yentzer*, *supra* (94 U. S. at 296-97, 24 L. ed. 106, 107); *Gill v. Wells*, *supra* (22 Wall. (U. S.) at 29, 22 L. ed. 711). Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the statute commands."

If, however, the Court were to give these "means" clauses a structural significance, then the only structural significance that can be given is the structure shown in the Mayo patent suit, or some structure which is substantially the same. *Such structures are not present in Petitioner's heaters.*

Petitioner's device is so completely different from the Mayo device that the Patent Office allowed a patent (Sperry patent 2,353,274, Rec. 143) on appellant's device after full consideration of the Mayo device. Even though Sperry lost Interference No. 73,751 with the Mayo patent, the fact that appellant obtained a patent on its radically and basically new device is conclusive proof that its device does not have substantially the same structure or operate in the same manner as the device of the patent in suit. Therefore, appellant's device and the Mayo patented device are not equivalents. Any "means" type claim which can be given an interpretation broad enough to cover appellant's device is either invalid or must be given an interpretation such that the claim is not infringed. This holds for the Mayo "means" claims 5 to 10, inclusive, and 12.

In regard to the Mayo claims 1 to 4, inclusive, certain language in these claims such as "adapted to draw another supply of air through a relatively smaller number of other of said passages to the interior of said casing" has been frowned on by the Circuit Court of Appeals in the Seventh Circuit and said to render the claim so indefinite that it is invalid (*Refrigeration Patents, Inc. v. Stewart-Warner, supra*).

In regard to the language above quoted the Court of Appeals said:

"We think the Halliburton case was not intended to eliminate the use of such convenient and uniformly understood descriptions."

It is submitted that the claim of the Mayo patent by the use of such "convenient" means terms covers completely non-equivalent devices, the very situation that the Supreme Court desired to correct in the *Halliburton case*. Petitioner's device is so completely different in structure and mode of operation that it was the basis of the Sperry patent 2,353,374 (R. 146), allowed by the Patent Office over the Mayo patent in suit (see file history of Sperry patent Ex. 35).

For the reasons stated, it is believed that the Writ should issue.

MAX W. ZABEL,  
FOSTER YORK,  
*Counsel for Petitioner.*

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CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1948.

No. 162

EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*

*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

**PETITIONER'S COMMENTS RE INACCURACIES IN  
RESPONDENT'S BRIEF.**

✓  
MAX W. ZABEL,  
FOSTER YORK,  
*Counsel for Petitioner.*



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---

**PETITIONER'S COMMENTS RE INACCURACIES IN  
RESPONDENT'S BRIEF.**

---

The misleading character of Respondent's Brief forces us to further burden the Court by calling attention to a few of the more glaring inaccuracies, feeling that this Court will by its own study of the case be able to appraise the remainder.

Respondent's Brief, p. 13, last paragraph, to the effect that the second decision by the Court of Customs and Patent Appeals did not nullify its prior ruling of prior inventorship in Mayo is a peculiar claim in view of the ruling by the Circuit Court of Appeals that it did (R. 460, lines 3 to 8). Please see the quotation to that effect in the last three lines of our brief, p. 15.

Re page 12 of Respondent's Brief to the effect that our statement re "three technically informed tribunals" must be taken "with a grain of salt" because, as claimed by

Respondent, these decisions merely say that "even taking the Sperry story as true, he cannot prevail".

Such a claim is utterly unfounded in any fact basis, as the Examiner of Interferences could not have awarded Sperry a "conception" in 1935 except on the basis of the existence of the Sperry devices in 1935. There is nothing such as "even taking—etc." in any of those six prior decisions, but there is the definite ruling of conception in 1935. The Interference Examiner in the very *first* of these six decisions on which we rely says:

"The testimony with respect to Sperry Exhibits 2 and 3 is not of a very satisfactory character in several respects but *it is deemed sufficient to establish the assembly* of these two exhibits in cooperative relation at least by the end of October, 1935." (Emphasis ours.) (R. 328, middle paragraph.)

That finding is part of all of these six decisions. Please see pp. 14 and 15 of our brief giving record designations.

Respondent, p. 11, says that there is no finding of fact that "Sperry constructed various embodiments of the device in suit in the year 1935". There is no finding of fact by the *Circuit Court of Appeals* to that effect, but six other tribunals have found to that effect. The Circuit Court of Appeals ruled out as irrelevant and immaterial (not incompetent) the very evidence (the second interference series) which brought about the reversal by the Court of Customs and Patent Appeals, and this despite stipulation with regard thereto. (Please see par. 6, R. 19.)

Re second paragraph, p. 9, of Respondent's Brief, we wonder what is meant by saying that Petitioner did not offer this "additional evidence" (the evidence referred to in the preceding paragraph). Why was it necessary for the Circuit Court of Appeals to rule it out as immaterial and irrelevant if it wasn't offered in evidence? By ruling it out the Circuit Court of Appeals foreclosed considera-

tion of the very evidence which prompted reversal by the Court of Customs and Patent Appeals and thus did the very opposite of that required under *Morgan v. Daniels* (153 U. S. 120). While the Court in its opinion discusses that evidence such discussion is based upon the erroneously assumed question of fact in regard to the *identity* of Exhibit 1 and Exhibit NN.

Re top of p. 16 (Par. beginning "It was pointedly") Respondent's Brief, may we say that Respondent *tried* to prove that the blower part Exhibit 1 could not have been in existence in 1935 and failed, but (inadvertently we believe) established that such blower part came from a mold used in 1935, (Exhibit N, pp. 288, 312, 360, and Exhibit M-28) thus further proving Sperry's case.

A careful reading of "Appellee's Comments on Appellant's Petition for Rehearing" (being the appendix to Respondent's Brief), fails to show us any passage which would support the ruling by the Circuit Court of Appeals that Sperry Exhibit 1 came from a mold which had not been made earlier than 1936.

With regard to the disclaimer question, we believe that Respondent sidesteps our point. The second decision by the Court of Customs and Patent Appeals was handed down April 3, 1944 (141 F. (2d) 816). This present suit was filed by *Petitioner* on September 21, 1945 (R. p. 2). Respondent thus for *over a year* neither filed a disclaimer nor did anything to test the validity of its patent following the decision by the Court of Customs and Patent Appeals which accorded to Sperry the invention date in 1935, prior to Mayo's earliest claimed date.

Respondent thus did nothing following notice of invalidity for over a year and, in all likelihood, would have never done anything but assert validity (as it did in this suit in its counterclaim) without a further test thereof, if *Petitioner* had not brought this suit.



By the opinion of the Circuit Court of Appeals claim 6 (the broadest claim) has been held invalid and Respondent has *acquiesced in that ruling* (Respondent's Brief, top of p. 17). For thus failing to disclaim, for over a year, after the adverse ruling by the Court of Customs and Patent Appeals and now admitting that at least one claim was invalid, Respondent has placed himself squarely under the rulings of this Court with respect to disclaimers, and the patent is invalid *in toto*. *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

While we have not covered all of the inaccuracies in Respondent's Brief, we feel that we have sufficiently shown such brief as failing to in any way alter or disturb our contentions.

MAX W. ZABEL,

FOSTER YORK,

*Counsel for Petitioner.*

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# UNITED STATES PATENT OFFICE

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Vol. 100

RENEWABLE ENERGY SYSTEM

THE ENERGY AND RADIATION MANUFACTURING  
COMPANY,

BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF HABEAS CORPUS

ARTHUR H. SOUTHERN  
Counsel for Respondent

100 W. Jackson Blvd.,  
Chicago 4, Illinois  
August 27, 1942



## SUBJECT INDEX.

	PAGE
Statement .....	1
Argument .....	4
The Petition	
Re Petitioner's "Summary Statement of Matter Involved" .....	4
Re Petitioner's Four "Questions Involved" .....	5
Re Petitioner's Six "Reasons for Granting the Writ" .....	7
Reply to Petitioner's Brief .....	8
Re Petitioner's "Statement" .....	8
Re Petitioner's Nine "Specifications of Errors" .....	9
Re Petitioner's "Argument" .....	11
I .....	11
II .....	14
III .....	15
IV .....	16
V .....	17

## TABLE OF CASES

### CITED

American Construction Company v. Jacksonville, Tampa and Key West Railway Company, 148 U. S. 372 .....	6
--	---

Frasch v. Moore, 211 U. S. 1 .....	5
Magnum Import Company, Inc., v. Coty, 262 U. S. 159 .....	6
Sperry v. Aufiero et al. (v. Mayo), 134 F. (2d) 174....	2
Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U. S. 471.....	12

# REFERRED TO

Halliburton Co. v. Walker, 329 U. S. 1.....	7, 10, 17
Morgan v. Daniels, 153 U. S. 120.....	11, 13
Sinclair Co. v. Interchemical Corporation, 325 U. S. 327 .....	14
Sperry v. Payne v. Teschner, 141 F. (2d) 816.....	4
Radio Corporation of America et al. v. Radio En- gineering Laboratories, Inc., 293 U. S. 1.....	9
Refrigeration Patents Inc. v. Stewart-Warner, 159 F. (2d) 972 .....	8, 10, 17

## *Opinions of the Courts Below.*

The opinion of the District Court is reported, *Excel v. Bishop and Babcock Mfg. Co.*, 73 U.S.P.Q., 475, and the opinion of the Circuit Court of Appeals for the Sixth Circuit is reported, *Excel v. Bishop and Babcock Mfg. Co.*, 167 F. 2d 962.

IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1948.

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**No. 162**

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**EXCEL AUTO RADIATOR COMPANY,**

Petitioner,

vs.

**THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,**

Respondent.

---

**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

---

Respondent is here confronted with a petition which is a work of confusion, permeated by argument. We shall treat such argument appropriately in our Argument to follow, but firstly in clarification and correction we make this

---

**Statement.**

The application for the Mayo patent in suit, for an automobile heater, was filed March 28, 1936 (R. pp. 33, 135).

In March 1937, Sperry, plaintiff's (petitioner's) general manager (since deceased), filed his patent application, assigning it to plaintiff (R. pp. 33, 143).

The Patent Office, finding common patentable subject matter in the two applications, placed them in interference, No. 73,751 (Def. Ex. I, R. p. 40) with six counts (claims). Mayo prevailed before the Patent Office tribunals and the Court of Customs and Patent Appeals (134 F. 2d 174), and the Mayo patent went to issue with those six counts as six of its thirteen claims.

Plaintiff (petitioner), in the instant suit, pleaded prior invention by Sperry (Complaint, Par. 7, R. pp. 5-6).

A pre-trial stipulation (March 18, 1946) provided (R. p. 17) that the depositions taken on behalf of Sperry, in said Interference No. 73,751, and accompanying exhibits,

“may be offered in evidence in this cause by plaintiff to all intents as though said depositions had been taken herein pursuant to the Rules of Civil Procedure for the District Courts of the United States.  
• • • ”.

Subsequently, pre-trial, defendant (respondent) took depositions (R. pp. 88-133) for purpose of disproof of the Sperry story as told in said depositions for Sperry.

At the trial, plaintiff offered said depositions for Sperry in evidence (Pl. Ex. 20, R. pp. 32-33), counsel for plaintiff adding (R. p. 33):

“Might I say we are not challenging what the Patent Office decided in the interference, and we are not asking for a re-decision of the Patent Office interference. It is just they are dictionary out of which certain things must be examined.”

The said depositions for Sperry were duly received in evidence.

No other evidence was adduced by plaintiff (petitioner) in support of its allegations of prior invention by Sperry.



Notwithstanding the above-quoted statement of plaintiff's counsel that they were not challenging what the Patent Office decided in the *Sperry v. Mayo* interference (73,751), they did not withdraw Paragraph 7 of the Complaint (R. p. 33), and defendant, when it came to its case, offered its above-mentioned depositions taken by it herein, with attendant exhibits (R. pp. 39, 43, 46), and the same were duly received in evidence.

---

Another paragraph (Par. 6, R. p. 19) of the said stipulation of March 18, 1946, makes reference to the printed transcripts of record (before the Court of Customs and Patent Appeals) in three other interferences, identified as Patent Appeal Docket No. 4776, No. 4777 and No. 4778 (Pl. Ex. 17, 18, 19; R. p. 32), the provision being that such transcripts, and accompanying exhibits, "may be offered by either party as exhibits, for the purpose of informing this Court of the record and exhibits upon which the decisions of said United States Court of Customs and Patent Appeals reported in 61 U. S. P. Q. 179-187 were rendered, but subject to the right of the other party to object to all or any parts thereof on the grounds of immateriality or irrelevancy."

Those three interferences had to do with other and subsidiary features claimed in the Sperry application and in one or both of two other applications (Payne and Teschner) owned or controlled by defendant (respondent). The issues there were those of priority, as between Sperry on the one hand, and Payne or Teschner on the other, and as to those particular features.

Plaintiff (petitioner) offered the three transcripts, with attendant further exhibits, and defendant (respondent) made objection on the ground of immateriality and irrelevancy (Rec. pp. 26-32), the Court deferring ruling and ultimately sustaining the objection (R. 435, 438).

The Court of Appeals affirmed that ruling (R. p. 460).

## **ARGUMENT.**

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It is in order, before proceeding to reply to petitioner's Argument beginning on Page 14, to comment on certain statements made in the preceding portions of petitioner's brief, and, indeed, in the petition itself.

### **The Petition.**

#### **Re Petitioner's "Summary Statement of Matter Involved".**

Although the patented heater has been widely adopted in the automobile industry (Finding of Fact 7, R. p. 434) the statement on Page 2 of the petition that it "is one used in the great majority of automobiles" is mere assertion by petitioner's counsel. It has no foundation in the record.

Their statement (p. 2) that the device "is two separate and distinct devices driven by one motor but mounted in *one* framework" is repetition of unsuccessful argument below on their allegation of aggregation.

Their statement (p. 2) that the patent in suit was "indicated" as invalid in the decisions of the Court of Customs and Patent Appeals in the Sperry-Payne-Teschner interferences referred to above (61 U.S.P.Q. 179-187, 141 F. 2d 816), made on Page 2 and repeatedly thereafter in their petition and brief, is a lawless attempt to endow opinion appraisal of evidence in another case, not involving the patent in suit or the same issues, with the force and effect of a judgment *contra* the one entered here. (Even the final judgment in the pertinent

Sperry-Mayo Interference 73,751 is not *res adjudicata* here. *Frasch v. Moore*, 211 U. S. 1, 9.)

What follows, for a page and a half, is sheer argument and assertion by counsel, repetition of their presentation below.

The point made at the bottom of Page 3 will be treated in Section V to follow.

The point made in the first paragraph on Page 4 is obviously without merit.

The statement in the second paragraph on Page 4 is repetition of unsuccessful argument below on plaintiff's contention of non-infringement.

The statement in the third paragraph on Page 4 is repetition of unsuccessful argument below on plaintiff's allegation of aggregation.

The statement in the fourth paragraph on Page 4 is another mere assertion by petitioner's counsel. It has no foundation in the record. If petitioner's counsel count on judicial notice being taken in this regard, we may be permitted to state that automobile heaters are made in several circuits in addition to the Sixth.

**Re: Petitioner's Four "Questions Involved".**

(Pages 4-5)

**As to No. 1.**

We do not see how there can be any such question as the one posed. Firstly, the Court of Appeals did not "overrule" the Court of Customs and Patent Appeals. It is in no position to do so. The decisions by the Court of Customs and Patent Appeals, which counsel refer

to, were decisions of priority as between Sperry and Teschner or Payne, and as to features peculiar to those cases. The decision of the Court of Appeals here does not and can not alter them. Secondly, the judgments of the Court of Customs and Patent Appeals in those cases must rest on the evidence in those cases, and the judgment of the Court of Appeals here must rest on the evidence in this case.

### As to No. 2.

We do not see how there can be any such question here. The accused device does not operate "upon an entirely different principle", and so both Courts below held; they held infringement, and not "simply because the patent contains 'means' claims which can be made to read on the device"; the decisions below speak for themselves in that regard (R. pp. 431, 432, 433, 458, 464, 467, 468).

Petitions for writs of certiorari are not granted merely to give the defeated party in the Circuit Court of Appeals another hearing.

*American Construction Company v. Jacksonville, Tampa and Key West Railway Company*, 148 U. S. 372, 382.

*Magnum Import Company, Inc. v. Coty*, 262 U. S. 159, 163.

### As to No. 3.

This is another question which was submitted and decided below, and another hearing should be denied.

*American Construction Company v. Jacksonville, Tampa and Key West Railway Company*, and *Magnum Import Company, Inc. v. Coty*, *supra*.

**As to No. 4.**

Upon the handing down, by the Court of Appeals, of its opinion in this case, respondent filed, in the Patent Office, disclaimer of Claim 6 (suggested to Mayo by the Patent Office for purpose of interference) of the patent in suit (publication in Official Gazette August 17, 1948).

Petitioner's point is that respondent should have disclaimed it upon the handing down of the decisions by the Court of Customs and Patent Appeals in the Sperry-Payne-Teschner cases.

The point is so far-fetched that special comment thereon is unnecessary here. (See Section IV, following).

**Re Petitioner's Six "Reasons for Granting the Writ."**

(Pages 5-6)

We comment on these in their order.

1. Our above comments as to petitioner's Question No. 1 apply here.

2. Our above comments as to petitioner's Question No. 1 apply here also.

3. Our above observation as to petitioner's Question No. 4 applies here.

4. As already pointed out, there is no basis in the record for this; and if petitioner's counsel count on judicial notice being taken in this regard, we may be permitted to state that automobile heaters are manufactured in circuits other than the Sixth and are installed and used across the entire country.

5. Our above comments as to petitioner's Question No. 2 apply here. The decision by the Court of Appeals in this case is not contrary to *Halliburton v. Walker*, 329

U. S. 1, or *Refrigeration Patents Inc. v. Stewart Warner*, 159 F. 2d 972, as will be pointed out in Section V to follow.

6. Petitioner's statement (p. 2) that the device here involved "is one used in the great majority of automobiles" is without foundation in the record.

### **REPLY TO PETITIONER'S BRIEF.**

We shall address ourselves firstly to a few comments on petitioner's "Statement", Pages 8-9.

On Page 8, petitioner states that the Sperry patent application was for a device "operating upon a novel and entirely different principle". That is not correct, the two Courts below decided to the contrary, and it will be remembered that petitioner contested the Sperry-Mayo interference (73, 751), for six claims which became claims of the Mayo patent in suit, through the Patent Office and the Court of Customs and Patent Appeals, with all decisions against it to finality in the latter.

The next four paragraphs (pp. 8-9) are argument of no moment here. There are no findings of fact here that there was any such activity by Sperry in 1935,—good, bad or indifferent. Were there foundation, counsel for petitioner should have sought such findings; but that they avoided.

Come now to the next paragraph (fourth full paragraph on Page 9):

What do petitioner's counsel mean by saying "In the course of the above proceedings" etc.? Sperry did not come into the interference proceedings until June 28, 1937 (at the earliest) (Pl. Ex. 35, R. p. 35), and Payne filed his patent application February 27, 1937 (Pl. Ex. 30, R. pp. 34, 317).

Petitioner's counsel's saying that Payne filed "about eleven months after the filing of the Sperry application" is an inadvertence on their part. Payne filed *before* Sperry filed.

As to the next argument of petitioner, from the bottom of Page 9 to the top of Page 11, it is enough to point out that petitioner's counsel did not offer the so-called elaborating additional evidence in the instant case; they purposefully avoided doing that.

The first full paragraph on Page 11 is unprincipled misstatements. The Court of Appeals did not exclude any "prior inventorship evidence". Nor did the District Court. No prior inventorship evidence was offered except the six depositions for Sperry from Interference 73, 751 (R. p. 32, Pl. Ex. 20) and the attendant exhibits (Pl. Ex. 1-11, R. pp. 26-31).

The three transcripts of Interference 75,056, 75,057 and 75,058 (Patent Appeal Docket No. 4776, No. 4777 and No. 4778) are not prior inventorship evidence; and it is clear that the Court of Appeals excluded those transcripts (for any purpose) because the applicants opposing Sperry in those cases were other than the inventor at bar and because the subject matter was other than that here involved (R. p. 460). The position of the Court of Appeals is correct and *Radio Corporation of America et al. v. Radio Engineering Laboratories*, 293 U. S. 1, so far as we can see, contains nothing to the contrary.

---

With reference to petitioner's nine "Specification of Errors" (pp. 11-13) we shall comment briefly on them in their order:



1. Our above comments as to petitioner's Question No. 1 apply here.

2. Our comments just above, as to the first full paragraph on Page 11, apply here.

3. Petitioner's counsel do not say what they meant to say (they apparently did not intend to use the word "not" in the second line). However, taking the sentence as apparently intended, it certainly was petitioner's burden, would it allege invalidity of the patent in suit, to prove it.

4. Firstly, our comments above, as to petitioner's Question No. 1, apply here. Secondly, the detail of which petitioner makes point did not alter the overall appraisal and conclusion of the Court of Appeals, as evidenced by the fact that petitioner made the same point in its petition for rehearing (R. pp. 469-475), and the Court saw fit to pass it by. Thirdly, counsel for petitioner has no right to comment upon respondent's reply to petitioner's petition for rehearing without including it in the record; however, in order to make it available to this Court, we include a reproduction of it as an appendix hereto.

5. Our comments above, as to petitioner's Question No. 4, apply here.

6. Our comments above, as to petitioner's Question No. 2, apply here. Also, the decision by the Court of Appeals in this case is not contrary to *Halliburton v. Walker* or *Refrigeration Patents Inc. v. Stewart Warner*, as will be pointed out in Section V to follow. (Incidentally the Court applied the doctrine of the *Halliburton* case to claim 6).

7. Our above comments as to petitioner's Question No. 1 apply here.

8. Petitions for writs of certiorari are not granted merely to give the defeated party in the Circuit Court of Appeals another hearing.

9. Petitions for writs of certiorari are not granted merely to give the defeated party in the Circuit Court of Appeals another hearing.

---

And now to petitioner's "Argument"

I.

(Pages 14-16)

In giving their reasons for contending "that this case comes under the doctrine of *Morgan v. Daniels*, 153 U. S. 120 and is paralled to one in which two Circuit Courts of Appeals have differed", petitioner's counsel start out by saying (p. 14) that Sperry constructed various embodiments of the device in suit in the year 1935.

There is no finding of fact to that effect.

That is mere assertion by petitioner, denied by respondent.

The pertinent findings of fact are as follows (R. p. 435):

"9. The only evidence adduced by plaintiff under Paragraph 7 of its Complaint, in which it alleges prior invention by one Philmore F. Sperry, is the same evidence adduced on behalf of said Sperry in Patent Office Interference No. 73751, involving said Sperry and said Mayo, on subject matter involved here, and, in that interference, said Mayo was found to be the first inventor of said subject matter."

. . .

"11. Plaintiff has not shown invention, prior to invention by said Mayo, of the subject matter of any of the claims of said Letters Patent No. 2,322,041, by said Sperry or any other".

And the Court of Appeals forcefully affirmed the District Court in this regard.

Petitioner presumes now to reargue this issue. This Court, as we understand it, ordinarily accepts concurrent findings of the District Court and Circuit Court of Appeals on factual matters.

*Universal Oil Products Co. v. Globe Oil Refining Co.*, 322 U. S. 471.

Petitioner's statement (p. 15) that "three technically informed tribunals" held the Sperry devices to have been in existence in 1935 must be taken with a grain of salt; viewed fairly and as a whole, these decisions say that, even taking the Sperry story as true, he can not prevail.

The statement of petitioner's counsel on Page 15 that the Sperry device "operated upon an entirely different and novel principle not disclosed in the Mayo patent application" is again mere assertion of counsel and reiteration of their arguments below. The findings of fact (Nos. 22-25, R. pp. 436-437), on the evidence, are directly to the contrary.

Coming to the third full paragraph on Page 15, what do petitioner's counsel mean by saying "During the course of the above proceedings, Payne, and also Teschner filed patent applications on a device following Sperry's principle"? The "above proceedings" did not begin until June 28, 1937 (at the earliest) so far as Sperry is concerned, and, as we have already pointed

out, Payne filed *before* Sperry; and Teschner filed April 15, 1937.

Petitioner's counsel go on to say (p. 15) that in the later interferences, involving the subsidiary features claimed by Sperry, Payne and Teschner, "further testimony was added in behalf of Sperry", and that this led to the favorable decisions by the Court of Customs and Patent Appeals in these cases. And then they say (top of Page 16) that

"it is in respect to this very testimony of the second interference proceeding that the Court of Appeals affirmed the District Court in excluding it on the ground of irrelevancy and immateriality".

It takes restraint to characterize that statement merely as misleading.

Petitioner's counsel never offered any such testimony.

What the Courts below ruled to exclude were simply the printed transcripts in these later interferences, and on proper grounds.

Petitioner's counsel had full opportunity to bring in such testimony here, but they did not do it, notwithstanding their burden of proof, would they claim prior invention by Sperry.

The argument of petitioner's counsel that the decisions by the Court of Customs and Patent Appeals in the *Sperry-Payne-Teschner* cases "nullified" its decision in the *Sperry-Mayo* case and that it "established" prior invention by Sperry as against Mayo as to the invention at bar is utterly without merit, and their attempt to invoke the doctrine of *Morgan v. Daniels* against respondent in this regard is preposterous.

## II.

(Page 17)

The argument of petitioner's counsel here is that, in ruling out the transcripts in Interference 75,056, 75,057 and 75,059 (Patent Appeal Docket No. 4776,, No. 4777 and No. 4778), with the attendant further exhibits, on the ground of immateriality and irrelevancy, the Court of Appeals departed from the principles of *Sinclair Co. v. Interchemical Corporation*, 325 U. S. 327, 330.

That portion of the *Sinclair v. Interchemical* case, to which counsel for petitioner refer, is as follows:

"There has been a tendency among the lower federal courts in infringement suits, to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. *Irvin v. Buick Motor Co.*, 88 F. 2d 947, 951; *Aero Spark Plug Co. v. B. G. Corp.*, 130 F. 2d 290; *Franklin v. Masonite Corp.*, 132 F. 2d 800. It has come to be recognized, however, that of the two questions, validity has the greater public importance, *Cover v. Schwartz*, 133 F. 2d 541, and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

This pronouncement, on its face, has no corrective pertinence to the case at bar.

Firstly, it does not in any way relate to the point of the Court's ruling above referred to.

Secondly, the Courts below found infringement, and, of necessity, weighed the issue of validity (R. pp. 431-433, 458-468), finding the patent valid.

## III.

(Pages 17-20)

The statement of petitioner's counsel here is that the Court of Appeals based its decision against prior inventorship by Sperry "*solely*" upon a "*single erroneously assumed, easily controvertible, alleged fact*" (italics theirs) (p. 17).

That statement is not correct.

The argument of petitioner's counsel as to said "erroneous assumption" (pp. 18-19) is precisely the same as that presented by it in its petition for rehearing (R. p. 469 et seq.), and it is clear, as we have already said, that the item could not and did not alter the Court's overall appraisal and conclusion, and it decided to pass it by.

Counsel repeat,—(p. 18) "No other fact is used as a basis for the Court's ruling". The attention of the Court is invited to the following portions of the Opinion:—Record, Page 462, lines 18-34, Page 463, first ten lines, and lines 17-27.

In the last full paragraph on Page 19, counsel for petitioner say that Sperry Exhibit 1 was not relied upon to prove either conception or reduction to practice. The point, however, is that Sperry presumes to use the alleged date of Exhibit 1 in placing dates of later exhibits (see Opinion, R. p. 463), and that alleged date is clearly not only not established, but is negatived by respondent's evidence.

In the next paragraph, counsel for Sperry say (pp. 19-20):

"The new testimony in this suit simply shows that Sperry may have been mistaken as to *where* the

blower originated but not as to its date. The date is material, not the place, and it was on the date that the Court of Appeals went astray."

It was pointedly on this matter of date that respondent's evidence disproved this critical piece of the Sperry story.

Petitioner's counsel go on to say (p. 20):

"The Court's error on this point is so clear that Respondent did not deny it."

Of course, as already pointed out, petitioner's counsel have no right to comment upon our reply to their petition for rehearing without including it in the record. Also, as already pointed out, we include a reproduction of it as an appendix hereto in order to make it available to this Court. Attention is invited to the first and second pages thereof in respect of what has just been said.

#### IV.

(Pages 20-21)

This argument by petitioner's counsel proceeds with tortious presentation, on the fantastic theory that the decisions in the Sperry-Payne-Teschner interferences constituted notice that all the claims of the Mayo patent were invalid, and that, since respondent did not disclaim them pursuant to such "notice", they are all invalid, now that Claim 6 has been held invalid by the Court of Appeals in this case.

It is clear, from what has already been said, that those decisions could not and did not constitute any such notice, and respondent has certainly been vindicated, by the instant case, in not considering them as any such notice.

Respondent had no reason to regard Claim 6 as invalid (and then only for non-compliance with Section 4888 of



the Revised Statutes) until the handing down of the opinion by the Court of Appeals herein, and, pursuant to that opinion, it filed, in the Patent Office, appropriate disclaimer of said claim.

## V.

(Pages 22-25)

Petitioner's argument here with reference to Claims 5, 7-10 and 12, is that the Court of Appeals, in the instant case, interpreted the case of *Halliburton Co. v. Walker*, 329 U. S. 1, differently than did the Court of Appeals for the Seventh Circuit in the case of *Refrigeration Patents Corp. v. Stewart-Warner Corp.*, 159 F. 2d 972.

We do not conceive that the decision of this Court in the *Halliburton* case categorically disapproves patent claims in which one or more elements are recited as means for doing this or that. Nor do we conceive, indeed, that the doctrine expressed in the *Halliburton* decision is a novel one, as the Court itself seems to say on Page 11 of the report.

The question of whether or not a claim is invalid for lack of compliance with Rev. Stat. 4888 is, of necessity, peculiar to each case, the test, as we understand it, being whether it would cover all ways of achieving a result, be the means equivalent or non-equivalent. In the *Halliburton v. Walker* case, that was the effect of the claim wording, the crucial element being described merely in terms of what it would do. The situation was quite analogous in the *Refrigeration Patents v. Stewart-Warner* case. In the instant case, the "means" recitations in the claims are of elements, conventional in and of themselves, and not admitting of non-equivalent alternatives.

On page 24, counsel for petitioner say that petitioner's device is "completely different" from the Mayo device. That issue has been fully tried, both Courts below finding to the contrary. Counsel also say that petitioner's device is "radically and basically new". That is not correct. The features to which its patent is directed are subsidiary, and their presence in the accused device does not alter the fact that the device firstly contains the invention of the patent in suit.

Counsel also say that the fact that petitioner obtained the Sperry patent "is conclusive proof that its device does not have substantially the same structure or operate in the same manner as the device of the patent in suit".

That, of course, is not so.

*Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319, 328.

Counsel for petitioner make a mere assertion of analogy between Claims 1 to 4, inclusive, of the patent in suit, and claims involved in the *Refrigeration Patents* case above referred to, and we think that comment thereon here is unnecessary.

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The petition for writ of certiorari is without merit and should be denied.

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We deplore the length and detail of this brief; in view of the manner and range of petitioner's presentation we could do no other.

Respectfully submitted,

ARTHUR H. BOETTCHER,

Counsel for Respondent.

53 W. Jackson Blvd.

Chicago 4, Illinois.

August 17, 1948.

# APPENDIX

IN THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE SIXTH CIRCUIT

---

**No. 10548**

---

EXCEL AUTO RADIATOR COMPANY,  
*Plaintiff-Appellant,*

vs.

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Defendant-Appellee.*

---

CIVIL ACTION NO. 22,354  
APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES  
FOR THE NORTHERN DISTRICT OF OHIO  
EASTERN DIVISION.

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**APPELLEE'S COMMENTS ON  
APPELLANT'S PETITION FOR REHEARING.**

---

We are aware that the rules of this Court do not provide for reply to a petition for rehearing, but we tender these comments, should the Court care to receive them.

1.

On page 4 of their petition, after referring to testimony on behalf of defendant in regard to its Exhibit M-28, counsel for plaintiff-appellant say:

"In view of this unquestioned testimony appellant has always regarded the so-called Midwest line of evidence as utterly immaterial, and incapable of proving anything of consequence in the case. We do not know for what purpose the Midwest evidence was introduced by appellee; its only effect could be to confuse the issues, as it obviously did."

We doubt that counsel for appellant do not know why the Midwest evidence was introduced by defendant. It was to disprove a critical piece of the Sperry story, and it does precisely that.

Mr. Sperry testified on cross examination (Plaintiff's Exhibit 20, pp. 51-52):

"XQ. 114. When Sperry Exhibit 1 was made up, where did you acquire the blower?

"A. That blower, a pair of blowers, right and left, were acquired from a bakelite molding company who *had previously supplied these blowers to a concern who made heaters for the Goodrich Rubber Company.*

"XQ. 115. Do you know which bakelite molding company that was?

"A. I believe it was the Midwest Molding Company.

"XQ. 116. Here in Chicago?

"A. That's right.

"XQ. 117. And what concern was it who made those heaters for the Goodrich Rubber Company?

"A. I believe it was a concern in Detroit, the name I don't recall."

(Italics ours.)

When investigation showed that Midwest's supply of blowers for Goodrich heaters did not begin until September, 1936, it was in order to take the available evidence in that regard. That evidence certainly established that fact, and the only alternative is that Mr. Sperry's explanation of the source of the blower wheel in his Exhibit 1 was total fabrication. Now, when and where Sperry or his department got the blower remains unknown to defendant and to the record. That it originated with Bishop & Babcock's supplier is indicated by the exhibit itself, which is plaintiff's dilemma, not defendant's. As the Court knows, plaintiff produced no witness at the trial; it announced (R. p. 33), referring to Interference 73,751 (the only one pertinent here):

"Mr. Zabel: Might I say we are not challenging what the Patent Office decided in the interference, and we are not asking for a re-decision of the Patent Office interference. It is just they are dictionary out of which certain things must be examined.

"Mr. Boettcher: Do I understand from that, so that we will save time, that you withdraw paragraph 7 of your Complaint?

"Mr. Zabel: No.

"Mr. Boettcher: You still leave it there."

Since the closing of the proofs, plaintiff-appellant has persistently challenged that decision; indeed, now it is confining itself to such challenge.

## 2.

The above constitutes one of the "monuments directly contrary to the Sperry story as told in the interference" (Our main brief, p. 54).

Another is this—

Mr. Sperry testified (Plaintiff's Exhibit 20, p. 39), and Mr. Lake testified (same exhibit, p. 61) that Sperry Exhibit 6 (Plaintiff's Exhibit 6) was mounted in an Excel H-60 heater, the H-60 heater being evidenced only by a picture in an Excel circular (Sperry Exhibit 7—Plaintiff's Exhibit 7).

The picture presents no dimensions, so we endeavored, in this case, to get the facts about those heaters. Calling Mr. Briskin, president of the plaintiff company, under Rule 26, we sought to have him produce an H-60 heater, or at least drawings of them, but to no avail (R. pp. 96-97). Whereupon, we located one ourselves, called Mr. Briskin again, and had him identify it (R. pp. 190-131). This H-60 heater is Defendant's Exhibit CC.

The two exhibits, Plaintiff's Exhibit 6 and Defendant's Exhibit CC, speak for themselves to the conclusion that Plaintiff's Exhibit 6 will not fit into Exhibit CC. It is enough to point out here that the over-all propeller fan diameter of Exhibit 6 is greater than the width of the casing of Exhibit CC.

## 3.

Another is this—

Mr. Lake testified on direct examination (Plaintiff's Exhibit 20, p. 63):

"Q. 25. Do you recall anything after your return from the 1935 sales lectures that would enable you to more definitely identify when you saw Sperry Exhibit 6?

"A. After returning from my 1935 sales trip I saw these two blowers (indicating Exhibits 2 and 4).

"Q. 26. Do you have anything written that would aid you in fixing the date?

"A. I have found a memorandum which I have here, which I wrote and dated on November 29, 1935, which definitely establishes the fact that shortly prior to this date that I had seen the defroster blower;"

(Mr. Lake, "advertising and selling for Excel Auto Radiator Company"—Plaintiff's Exhibit 20, p. 60—doing a bit of selling on the witness stand.)

"as a matter of fact, I saw both of those before this time (indicating Exhibits 2 and 4)."

The memorandum referred to, Plaintiff's Exhibit 10, lists "11. Defroster Attachment", and the above quoted testimony could mislead the chancellor if he did not know that, at the time of that memorandum, Excel had a "defroster attachment", a hose connection, for its H-60 heater (which had only the one conventional propeller fan), piping some of the hot air in the casing up to the

windshield. That fact was established here by further examination of Mr. Briskin, as follows, with reference to this H-60 heater, Defendant's Exhibit CC (Exhibit R in the deposition) (R. pp. 131-132):

"Q. 13. Mr. Briskin, in some remarks that you have made off the record you mentioned an opening for a defroster connection. Will you please state on the record what that remark was.

"A. 13. We decided to put a defroster attachment on here. There was a round hole in the body here (indicating) to put in the defroster attachment in the side, as it comes off the fan. We had a nozzle that went up to the windshield.

"Q. 14. Mr. Briskin, will you please mark the casing, showing just what you mean by an opening for a defroster connection.

"A. 14. A round hole right here (indicating). Then we had a little hole here for a screw, and then we had a little flange. I don't know whether it was a 1 $\frac{3}{4}$  or 2-inch opening there for a defroster opening, if anybody wanted a defroster in there. Now, the Raffel Manufacturing Company put in a die when they built a die in 1932.

"By Mr. Boettcher: Let the record show that the witness has drawn a circle, and two small circles, with a blue pencil, on the side of the casing of Exhibit R."

(Those markings on the exhibit are covered with a piece of cellophane.)

The attention of the Court is invited to the exhibit, now Defendant's Exhibit CC.

If the Sperry story were a true one, Mr. Lake would have been a key witness for explanatory testimony for the plaintiff in this case. Plaintiff's counsel didn't call him.

On pages 4-5 of their petition for rehearing, plaintiff's counsel argue that the decisions of the Court of Customs and Patents Appeals in the Sperry-Payne-Teschner interferences (75,056, 75,057 and 75,058) have effect, and determinative effect, in this case.

That is clearly wrong for a number of reasons.

Firstly, those cases are immaterial and irrelevant here because the issues there were of first inventorship, as between Sperry and Payne or Teschner, not as between Sperry and Mayo, and of subject matter different from that involved here. (The fact that defendant-appellee was assignee of Mayo and Teschner and in privity with Payne can not alter that in the slightest.)

Secondly, even the decision in a material and relevant interference, like Interference 73,751, is not binding on the Court here. *United Shoe Machinery Corporation v. Muther*, 288 F. 283.

Thirdly, the depositions printed in the transcripts, Exhibits 17, 18 and 19, are not testimony in this case, and plaintiff's attempted use of them as such is a gross abuse of Paragraph 6 of the stipulation of March 18, 1946 (R. p. 19).

Fourthly, defendant's evidence in this case shows that the Court was misled in the Sperry-Payne-Teschner cases.

As to plaintiff's attempt to invoke the rule of *Morgan v. Daniels* against defendant, it suffices to say that the burden of proof of prior invention is upon him who alleges it.

On page 6 of their petition for rehearing, plaintiff's counsel, for the first time, question the award of attor-



ney's fees in the judgment (R. p. 439). Under the statute, such award lay in the discretion of the District Court, it is appropriate in this case, it was not questioned on this appeal, and it is clearly improper to question it before this Court now.

## 6.

As to Claim 6 of the patent in suit: In view of the opinion of this Court as to this claim, defendant is disclaiming it, and we think the mandate should direct the District Court to amend the judgment to accordance with said opinion.

Respectfully submitted,

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**FILE COPY**

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**FILED**

**OCT 25 1948**

**CHARLES ELMORE CROFLEY**  
**CLERK**

**IN THE**  
**Supreme Court of the United States**

**OCTOBER TERM, 1948.**

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**No. 162**

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**EXCEL AUTO RADIATOR COMPANY,**  
*Petitioner,*

*vs.*

**THE BISHOP AND BABCOCK MANUFACTURING**  
**COMPANY,**  
*Respondent.*

---

**PETITION FOR REHEARING.**

---

**MAX W. ZABEL,**  
**FOSTER YORK,**  
*Counsel for Petitioner.*



IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

---

**No. 162.**

---

EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*

*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

---

**PETITION FOR REHEARING.**

---

*To the Honorable Frederick M. Vinson, Chief Justice of  
the United States, and the Associate Justices of the  
Supreme Court of the United States:*

Your petitioner respectfully requests that the Court reconsider its action of October 11, 1948 denying the petition for writ of certiorari filed herein; that the order then entered be vacated; and that a writ of certiorari to the United States Court of Appeals for the Sixth Circuit be granted according to the prayer of said petition.

The discretionary power of this Court is respectfully invoked for the following reasons:

**Reason 1.**

The Court of Appeals for the Sixth Circuit has committed a fundamental error of law by applying the doctrine of *Rousso v. First National Bank*, 37 F. 2d 281, to this case rather than the doctrine of *Morgan v. Daniels*, 153 U. S. 120. The Rousso doctrine is applicable when one of the parties to a later infringement suit is a *stranger* to an earlier interference dealing with the same invention, while the Morgan doctrine is applicable when the parties to the two proceedings are the *same*. The Court's refusal to apply the Morgan doctrine was based upon its unwillingness to accord to a common "assignee" the standing of a common "party". In other words, the Court disregarded the *real party in interest* aspect of respondent, and in effect divorced the common assignee from its inventor-assignors. Since there is clearly no legal justification for this view, the Court was in error for not applying the well established doctrine of *Morgan v. Daniels*.

**Reason 2.**

Certain new evidence was presented in the infringement action, and this evidence prompted the Court of Appeals, in its evaluation of the case under the Rousso doctrine, to reverse the interference decision. Such evidence, as we shall show, could not possibly have brought about this result under the "thorough conviction" criterion of the Morgan doctrine. This new evidence was offered in an attempt to disprove certain testimony given in the interference. This testimony, as will be seen, was "belief" testimony—the witness "believed" he obtained his blower from such and such a place. This language is inherently capable of two interpretations. The Court of Appeals, upon being convinced by the new evidence that the blower could not have been obtained from that place *at the time*

*alleged*, concluded that the witness was in error as to the time he acquired the blower. Overlooked was the possibility that the witness was wrong in his "belief" as to the *origin* of the blower, and that it was actually derived from another source. The new evidence, applied as it was to "belief" testimony, is manifestly incapable under the "thorough conviction" criterion of the Morgan doctrine of upsetting the interference decision, which, if upheld, spells invalidity of the Mayo patent in suit.

---

A brief resumé of this litigation will be helpful to demonstrate the anomalous position occupied by petitioner as a result of the Court of Appeals' decision. It likewise will demonstrate the need for reviewing this case so that a repetition of the situation will not occur.

Petitioner and respondent have been common adversaries in three *inter partes* proceedings involving automobile heater inventions. Two proceedings have been interference actions, and the third is the present declaratory judgment infringement action.

The first interference concerned itself with the precise invention involved in this action. The named parties were Sperry and Mayo, *assignors* of petitioner and respondent respectively. Mayo prevailed in this interference before the Court of Customs and Patent Appeals, 134 F. (2d) 174, on the narrow, technical ground that Sperry, although he had made models at an early date, had "failed to reduce his invention to practice" prior to the filing date of Mayo's patent application. Subsequently the Mayo patent in suit was issued to respondent.

The second interference involved another, but intimately related, aspect of the same subject matter. This interference was between Sperry's *same application* on behalf of petitioner, and the applications of *assignors* Payne and Teschner on behalf of respondent. On the critical question of reduction to practice, Sperry presented additional

evidence, and this time the Court of Customs and Patent Appeals *reversed* its former decision, and held that Sperry had in fact reduced his invention to practice as required by law. 141 F. (2d) 816. Subsequently the Sperry patent was issued to petitioner.

This reversal by the Court of Customs and Patent Appeals left petitioner in the anomalous position of being unable to practice the invention of its Sperry patent because of the existence of the previously issued, dominating Mayo patent in suit.

The present declaratory judgment infringement action was instituted to remove what was considered to be merely a formal cloud on petitioner's right to practice the invention of the Sperry patent.

Since petitioner's rights in both interferences were based on its single Sperry application, and since respondent was the *adverse party* in both proceedings, petitioner naturally expected that the Court in the declaratory judgment action would follow the holding of the Court of Customs and Patent Appeals in the second interference under the well established administrative law doctrine of *Morgan v. Daniels*, 153 U. S. 120. Such a holding would have spelled invalidity of the Mayo patent in suit on the ground that Mayo was not the first inventor. This the Court did not do, and the reasons that prompted the Court not to do so are, we insist, fundamentally in error.

#### **Discussion of Reason 1.**

In refusing to apply the Morgan doctrine, the Court of Appeals stated (R. 460) that

"The final ruling of the Court of Customs and Patent Appeals (141 Fed. 2d 816) on the question of priority between Sperry, Payne and Teschner, does not bind this court, since Mayo was not a party to those proceedings."

It is apparent that the Court relied upon the distinction between the individual inventors Payne, Teschner and Mayo, and totally disregarded the fact that respondent was the *common assignee* of each of the said individuals. (Respondent's status as Mayo's assignee is admitted in the pleadings; its status as to Payne was admitted at the trial (R. 29); and its status as to Teschner is set forth in Exhibit 19, pp. 4 and 245.) As a common assignee, respondent has been one of the real parties in interest in each proceeding, while petitioner has been the other real party in interest. The Court also disregarded the fact that the question of reduction to practice was common to and critical in all three proceedings.

An assignee of an inventor has exactly the same standing as the inventor himself would have had in the absence of assignment. This is apparent from Sec. 4918 (U. S. C. title 35, sec. 66). To the same effect is Rule 94, Rules of Practice of the U. S. Patent Office.

Therefore, respondent, a common assignee and thus a real party in interest, should be given the standing of a "party" within the Morgan doctrine. This the Court of Appeals failed to do, and as a result, the legal scope of the Morgan doctrine has been rendered indefinite.

A review of this case is necessary to clarify this uncertainty.

The decision of the Court of Appeals, in brief, holds that an assignee-party to an infringement suit is *not bound* by the decision *on a common question* in a previous interference proceeding wherein the same assignee also was a party, the assignors in the two instances being different inventors. To allow this decision to stand without review introduces fatal uncertainty into the patent law with respect to the scope of the Morgan doctrine.



### Discussion of Reason 2.

Upon determination that this case is properly subject to the Morgan doctrine, it is necessary to pass upon one further point that influenced the decision of the Court of Appeals. This point involves a brief consideration of the new evidence presented in the infringement action, and its effect upon the interference testimony it attempted to disprove.

The questioned interference testimony involves statements that obviously were capable of two interpretations, one of which under the circumstances was favorable to petitioner, and the other unfavorable. The Court of Appeals arbitrarily adopted the unfavorable interpretation, and thereupon concluded in the light of the new evidence that the witness made a mistake. This mistake was deemed fatal to petitioner's case. The question presented by this circumstance is—Does this *possibility of discrepancy* amount to evidence of such "thorough conviction" that, under the Morgan doctrine, the interference decision should be reversed? We are confident that it does not.

The one-sided interpretation of the testimony by the Court of Appeals may be demonstrated by quoting from the Sperry deposition, petitioner's (plaintiff's) Exhibit 20, p. 52:

"XQ. 114. When Sperry Exhibit 1 was made up where did you acquire the blower?

A. That blower, a pair of blowers, right and left, were acquired from a bakelite molding company who had previously supplied these blowers to a concern who made heaters for the Goodrich Rubber Company.

XQ. 115. Do you know which bakelite molding company that was?

A. I *believe* it was the Midwest Molding Company.

XQ. 116. Here in Chicago?

A. That's right.

XQ. 117. And what concern was it who made those heaters for the Goodrich Rubber Company?

A. I *believe* it was a concern in Detroit, the name I don't recall." (Emphasis ours.)

The Court of Appeals summarized this testimony by the statement that

"Sperry testified that in his first model he used a pair of blowers acquired from a bakelite molding company, the Midwest Molding and Manufacturing Company of Chicago."

In other words, the Court of Appeals interpreted the "belief" testimony to mean that the witness *stated with certainty* that he obtained his blowers from Midwest.

Admittedly the new evidence established that the witness could not have obtained the blowers from Midwest at the time he claimed to have acquired them. Nevertheless, that is no reason to rule out arbitrarily the possibility that the witness was in error as to his belief, and that he acquired the blowers at the time alleged from a different source. In any event, the new evidence obviously lacks the "thorough conviction" necessary under the Morgan doctrine to authorize a Court to reverse the determination of a common question made by the Court of Customs and Patent Appeals in a previous contest between the same real parties in interest.

**Conclusion.**

For the above reasons, it seems clear that the Court ought not to permit the judgment of the Court of Appeals to stand without review, particularly from the standpoint of the proper application of the *Morgan v. Daniels* doctrine.

Respectfully submitted,

MAX W. ZABEL,

FOSTER YORK,

*Counsel for Petitioner.*

I, Max W. Zabel, counsel for the above named petitioner, do hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay, and that it is based upon substantial grounds available to petitioner although not previously presented.

MAX W. ZABEL,

*Counsel for Petitioner.*



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U.S. SUPREME COURT

1945

SUPREME COURT OF THE UNITED STATES

October Term, 1945

No. 162

EXCEL AUTO RADIATOR COMPANY,

Petitioner,

vs.

THE BISHOP AND MANUOE MANUFACTURING  
COMPANY,

Respondent.

MEMORANDUM IN REPLY TO  
PETITION FOR REHEARING

↓  
ARTHUR H. BOETTCHER,  
Counsel for Respondent.

21 W. Jackson Blvd.,  
Chicago 4, Illinois.  
November 17, 1945.  
Respectfully,  
Arthur H. Boettcher



IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1948.

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**No. 162**

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**EXCEL AUTO RADIATOR COMPANY,**

**Petitioner,**

**VS.**

**THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,**

**Respondent.**

---

**MEMORANDUM IN REPLY TO  
PETITION FOR REHEARING.**

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This is a patent validity and infringement case which has been fully presented below, in which rehearing was denied by the Court of Appeals, and in which a petition for writ of certiorari has once been denied by this Court.

Petitioner presents two purported grounds for its petition for rehearing. Neither of them is new. Both were presented in the original petition for writ of certiorari.

The first, entitled by petitioner as "Reason 1", was presented on Pages 3, 4, 5, 6, 11, 12, 14-16, 20 and 21 of its original petition and brief before this Court. Respondent replied on Pages 5-6 and 11-13 of its brief in opposition.

The second, entitled by petitioner as "Reason 2", was presented on Pages 3, 4, 5, 6, 10, 12, 17-20 of its original petition and brief before this Court. Respondent replied on Pages 10, 15-16 (note reference to appendix) of its brief in opposition.

It is at once apparent, therefore, that the instant petition disregards Rule 33 (Rehearing), Paragraph 2, of this Court, which paragraph provides that

"Any petition filed under this paragraph must briefly and distinctly state grounds which are confined to intervening circumstances of substantial or controlling effect \* \* \*, or to other substantial grounds available to petitioner although not previously presented \* \* \*."

We assume that any repetitious reply argument here, in respect of petitioner's thus exhausted grounds, would likewise be out of order.

The instant petition also violates the following provision of said paragraph of said Rule:

"A petition for rehearing filed under this paragraph must be supported by a certificate of counsel to the effect that it is presented in good faith and not for delay, and counsel must also certify that the petition is restricted to the grounds above specified."

Since the instant petition, on its face, is not restricted to intervening circumstances or to grounds not previously presented, it precludes the second required certification, and no such certification is made. The first, which is made, rests with the conscience of the certifier.

The petition should be denied.

Respectfully submitted,

ARTHUR H. BOETTCHER,  
Counsel for Respondent.

53 W. Jackson Blvd.  
Chicago 4, Illinois.  
October 29, 1948.



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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

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**No. 162**

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EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*

*vs.*

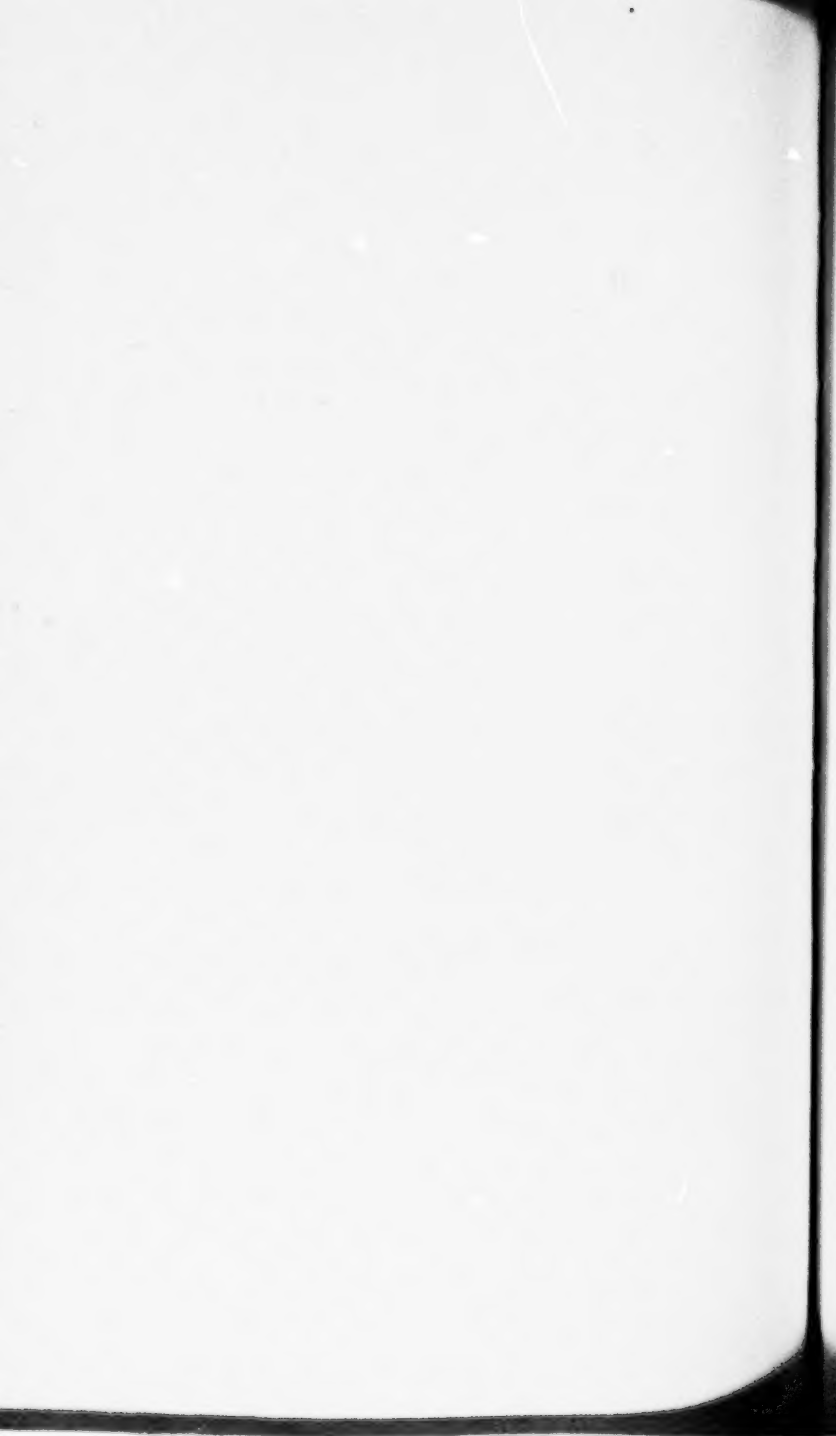
THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

---

**MOTION FOR LEAVE TO FILE PETITION FOR  
REHEARING AND PETITION FOR  
REHEARING.**

---

MAX W. ZABEL,  
FOSTER YORK,  
*Counsel for Petitioner.*



IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

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**No. 162.**

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EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*  
*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

---

MOTION FOR LEAVE TO FILE PETITION FOR  
REHEARING.

---

*To the Honorable Frederick M. Vinson, Chief Justice of  
the United States, and the Associate Justices of the  
Supreme Court of the United States:*

Your Petitioner respectfully requests leave to file the accompanying (second) petition for rehearing of the petition for writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit in the above entitled case, denied by this Court October 11, 1948; petition for rehearing denied November 15, 1948.

### Reasons for Asking Leave.

In said petition for writ of certiorari on page 6, there was alleged as one reason for granting certiorari that no other litigation involving the patent was foreseeable except in the Sixth Circuit. After the order denying the petition for writ of certiorari, circumstances have occurred which unequivocally show a design on the part of respondent to confine litigation to the Sixth Circuit. Respondent has it within its power to do so. These circumstances are as follows:

1. On December 27, 1948, Respondent, The Bishop and Babcock Manufacturing Company, filed a patent infringement suit against Sears, Roebuck and Co. in the District Court of the United States for the Northern District of Ohio, Eastern Division, charging infringement of the patent in suit despite the fact that the alleged infringement by Sears, Roebuck and Co. was the sale of heaters manufactured by the E. A. Laboratories, Inc. who manufacture the said heaters in New York in the Second Circuit.

2. Petitioner has been informed by the attorney for E. A. Laboratories, Inc. that he has investigated the possibilities of filing a declaratory judgment suit against The Bishop and Babcock Manufacturing Company in view of the suit by The Bishop and Babcock Manufacturing Company against E. A. Laboratories' customers, but has found that such a suit cannot be brought outside of the Sixth Circuit since The Bishop and Babcock Manufacturing Company resides in the Sixth Circuit and is not registered to do business in any state outside of the Sixth Circuit.

3. Upon information and belief Petitioner also states that Respondent sells heaters coming under the Mayo patent involved in suit between Petitioner and Respondent through The Bishop and Babcock Sales Corporation, a sep-

arate corporate entity and a corporation of New York. By using this corporation to make sales in New York and other states outside of the Sixth Circuit, Respondent is enabled in effect to do business outside of the Sixth Circuit without being subject to a declaratory judgment suit to have its patent declared invalid outside of the Sixth Circuit.

It is believed that the above facts constitute well recognized ground for the exercise of jurisdiction by this Court, as more completely set forth in the proposed Petition for Rehearing.

Cases in which this Court has granted leave to file a petition for rehearing of an order denying a petition for writ of certiorari after the expiration of the period allowed by Rule 33 in similar circumstances include:

*Kellogg Company v. National Biscuit Company*,  
304 U. S. 586; s. c. 302 U. S. 733, 777.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 304  
U. S. 587; s. c. 303 U. S. 639, 667.

*Paramount Publix Corp. v. American Tri-Ergon  
Corp.*, 293 U. S. 528, 55 S. Ct. 139, 79 L. Ed. 638.

*Altoona Publix Theatres, Inc. v. American Tri-  
Ergon Corp.*, 293 U. S. 528, 55 S. Ct. 139, 79 L.  
Ed. 638.

We respectfully submit that this Court should grant Petitioner leave to file the accompanying petition for rehearing of the petition for writ of certiorari to the Court of Appeals for the Sixth Circuit in the instant case, denied October 11, 1948, and that the accompanying petition for rehearing should be granted.

Respectfully submitted,

MAX W. ZABEL,

FOSTER YORK,

*Counsel for Petitioner.*





IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

---

**No. 162.**

---

EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*

*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

---

PETITION FOR REHEARING.

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*To the Honorable Frederick M. Vinson, Chief Justice of  
the United States, and the Associate Justices of the  
Supreme Court of the United States:*

Your Petitioner respectfully requests that the Court reconsider its action of October 11, 1948, denying Petitioner's petition for writ of certiorari filed in the above entitled case July 19, 1948; that the order then entered in the case be revoked or vacated; and that a writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit be granted according to the prayer of said petition.

The reason for this petition is that in the said petition for writ of certiorari on page 6, there was alleged as one reason for granting certiorari that no other litigation in-

volving the patent was foreseeable except in the Sixth Circuit. After the order denying the petition for writ of certiorari, circumstances have occurred which show a definite intention on the part of Respondent to confine litigation to the Sixth Circuit. Respondent has the power to carry out such intention. These circumstances are as follows:

1. On December 27, 1948, Respondent, The Bishop and Babcock Manufacturing Company, filed a patent infringement suit against Sears, Roebuck and Co. in the District Court of the United States for the Northern District of Ohio, Eastern Division, charging infringement of the patent in suit despite the fact that the alleged infringement by Sears, Roebuck and Co. was the sale of heaters manufactured by the E. A. Laboratories, Inc. who manufacture the said heaters in New York in the Second Circuit.

2. Petitioner has been informed by the attorney for E. A. Laboratories, Inc. that he has investigated the possibilities of filing a declaratory judgment suit against The Bishop and Babcock Manufacturing Company in view of the suit by The Bishop and Babcock Manufacturing Company against E. A. Laboratories' customers, but has found that such a suit cannot be brought outside of the Sixth Circuit since The Bishop and Babcock Manufacturing Company resides in the Sixth Circuit and is not registered to do business in any state outside of the Sixth Circuit.

3. Upon information and belief Petitioner also states that Respondent sells heaters coming under the Mayo patent involved in suit between Petitioner and Respondent through The Bishop and Babcock Sales Corporation, a separate corporate entity and a corporation of New York. By using this corporation to make sales in New York and other states outside of the Sixth Circuit, Respondent is enabled in effect to do business outside of the Sixth Circuit without being subject to a declaratory judgment suit

to have its patent declared invalid outside of the Sixth Circuit.

The peculiar circumstances that make it possible for Respondent to accomplish its purpose by bringing suit in this Sixth Circuit alone are that the great majority of automobile heaters are assembled in cars that are made in the Sixth Circuit, or are sold by mail order houses which sell in the Sixth Circuit. Thus the automobile manufacturer may be enjoined from assembling such heaters, and the heater manufacturer, no matter what circuit he is in, will, on such suit in the Sixth Circuit, be unable to sell heaters and will be unable to test the validity of the patent in any other circuit since Respondent need not sue him, and as shown by the aforementioned facts, will not sue him. Neither will he be able to bring a declaratory judgment suit elsewhere since Respondent is registered to do business only in Ohio, its place of incorporation.

An affidavit of David S. Kane, attorney for E. A. Laboratories, Inc., swearing to the aforementioned facts, is presented at the end of this Petition.

Cases in which this Court has granted a petition for rehearing and revoked or vacated an order denying certiorari, and granted such writ in similar circumstances include:

*Kellogg Company v. National Biscuit Company*,  
304 U. S. 586; s. c. 302 U. S. 777, 733.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 304  
U. S. 587; s. c. 303 U. S. 667, 639.

*Paramount Publix Corp. v. American Tri-Ergon Corp.*, 293 U. S. 528, 55 S. Ct. 139, 79 L. Ed. 639.

*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 293 U. S. 528, 55 S. Ct., 139, 79 L. Ed. 638.

Considering then the fatal disabilities under which this patent is laboring (as pointed out in our Petition for Certiorari) it is now clear from Respondent's conduct subsequently to the filing of said petition, that, good or bad, this patent will remain unchallenged as to its validity throughout its life unless this Court grant our petition.

Respectfully submitted,

MAX W. ZABEL,  
FOSTER YORK,  
*Counsel for Petitioner.*

I, Max W. Zabel, counsel for the above named petitioner, do hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay, and that it is based upon intervening circumstances of substantial and controlling effect.

MAX W. ZABEL,  
*Counsel for Petitioner.*

## AFFIDAVIT OF DAVID S. KANE.

STATE OF NEW YORK, }  
COUNTY OF NEW YORK. } ss.

DAVID S. KANE, being duly sworn, deposes and says that he is the attorney for the E. A. Laboratories, Inc., a corporation organized and existing under and by virtue of the laws of the State of New York; that E. A. Laboratories, Inc. manufactures heaters in New York and sells such heaters to Sears, Roebuck and Company, a corporation organized and existing under and by virtue of the laws of the State of New York; that on December 27, 1948, The Bishop and Babcock Manufacturing Company, a corporation organized and existing under and by virtue of the laws of the State of Ohio, filed patent infringement suit against Sears, Roebuck and Company in the District Court of the United States for the Northern District of Ohio, Eastern Division, alleging infringement of the Mayo patent 2,322,041 by virtue of the sale by Sears, Roebuck and Company of said E. A. Laboratories, Inc. heaters; that he has investigated the possibilities of bringing a declaratory judgment suit on behalf of his client, E. A. Laboratories, Inc. against The Bishop and Babcock Manufacturing Company in New York City, and elsewhere outside of the Sixth Circuit; that he has received letters from the Secretaries of State of all states in the United States, and that the Secretaries of all states outside of Ohio in the Sixth Circuit state that The Bishop and Babcock Manufacturing Company is not registered to do business in the state of which they are secretaries, and that he has advised his client that a declaratory judgment suit cannot be brought against The Bishop and Babcock Manufacturing Company in any state outside

of the Sixth Circuit; that The Bishop and Babcock Manufacturing Company sells heaters coming under the aforementioned Mayo patent through The Bishop and Babcock Sales Corporation, a separate corporate entity and a corporation of New York; that the great majority of automobile heaters are assembled in cars that are made in the Sixth Circuit, or are sold by mail order companies that sell in the Sixth Circuit; and that he has been informed by Sears, Roebuck and Company that unless he is successful in defending the suit in the Sixth Circuit his client will not receive any further orders for heaters from Sears, Roebuck and Company.

(Signed) DAVID S. KANE.

Subscribed and sworn to before me this 27th day of April, 1949.

(Signed) VLASTA L. KNAKAL,

(NOTARIAL SEAL)

*Notary Public.*

My commission expires March 30, 1950.

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Office - Supreme Court, U. S.  
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MAY 21 1949

CHARLES ELMORE CROPLEY  
CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

**No. 162**

EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*  
*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

**MEMORANDUM IN REPLY TO MOTION FOR LEAVE  
TO FILE PETITION FOR REHEARING AND PETI-  
TION FOR REHEARING.**

✓ JOHN A. DIENNER,  
53 W. Jackson Blvd.,  
Chicago 4, Illinois,

✓ JOHN T. SCOTT,  
1649 Union Commerce Bldg.,  
Cleveland 14, Ohio,  
*Counsel for Respondent.*

May 20, 1949.





IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948.

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**No. 162.**

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EXCEL AUTO RADIATOR COMPANY,  
*Petitioner,*  
*vs.*

THE BISHOP AND BABCOCK MANUFACTURING  
COMPANY,  
*Respondent.*

---

**MEMORANDUM IN REPLY TO MOTION FOR LEAVE  
TO FILE PETITION FOR REHEARING AND PETI-  
TION FOR REHEARING.**

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The Petitioner, Excel Auto Radiator Company, on July 19, 1948, filed a petition for a writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit in this suit, wherein the Circuit Court of Appeals sustained the validity of a patent granted to the Respondent, one of the grounds upon which the petition was based being that "the patent covers such devices (automobile heaters) broadly, and as its use is confined to the automobile trade which is concentrated in the Sixth Circuit, no other litigation is foreseeable". This petition for a writ of certiorari was denied by the United States Supreme Court on October 11, 1948. A petition for rehearing was filed in this Court by the Petitioner on October 25, 1948,

and was denied by this Court on November 15, 1948. The Petitioner has now, on May 7, 1949, filed its motion for leave to file a second petition for rehearing of the petition for a writ of certiorari. The ground for the motion for leave to file the second petition for rehearing is the same as the above mentioned ground urged in the original petition for a writ of certiorari, to wit, that the validity of the patent is not likely to be again litigated outside of the Sixth Circuit.

We understand that it is not usual to file a memorandum in opposition to a motion for leave to file a petition for rehearing on a petition for writ of certiorari, but the statements made by the Petitioner in its motion for leave to file a second petition for rehearing and in the said petition are so misleading (and some untrue) that a brief statement as to the facts may be in order.

The patent upheld by the Circuit Court of Appeals for the Sixth Circuit is on an improved automobile heater described therein. Automobile heaters are accessories which are sold by automobile manufacturers as optional equipment and are also sold by independent automotive accessory jobbers, stores and dealers located in the various communities throughout the United States. Automobile heaters are of many different types, and of the automobile heaters now being sold by the automobile manufacturers, only a small percentage are of a type covered by any of the claims of the patent in suit. (By far the majority of the automobile heaters sold by the automobile manufacturers are now being manufactured by the automobile companies themselves, General Motors Corporation, Chrysler Corporation, The Studebaker Corporation and Nash-Kelvinator Corporation manufacturing all of their heaters for passenger cars.) The best market now remaining to independent manufacturers of automobile heaters is the market furnished by many thousands of independent

automotive accessory jobbers and stores and other dealers in automotive accessories. Except for a very few large chain stores, these independent jobbers and stores and other dealers in automotive accessories sell automobile heaters only in their own localities (and some large chain stores do not do business in the Sixth Circuit) so that if they sell infringing automobile heaters, they could be sued for infringement only in the judicial circuit where the particular jobber, store or dealer is located. There are, besides the Respondent, at least eight independent manufacturers of automobile heaters which sell their heaters to the independent jobbers, stores and dealers in automobile accessories. All of these eight independent manufacturers are located outside of the Sixth Circuit. The result is that if Respondent's patent should be infringed by any of these independent manufacturing concerns, or by any of the many thousands of independent jobbers and stores and other dealers in automotive accessories, except those jobbers, stores and dealers doing a local business in the Sixth Circuit and a very few chain stores having stores in the Sixth Circuit as well as in other Circuits, the Respondent would be obliged to go outside of the Sixth Circuit in order to sue such infringers, although the Petitioner apparently seeks to convey a contrary impression in its motion and petition for a rehearing. The only new event alleged by the Petitioner in its second petition for a rehearing is that the Respondent has brought a suit against Sears, Roebuck and Co. in the Sixth Circuit for infringement of the patent in suit, but this event is without significance since Sears, Roebuck and Co. has six stores in the Respondent's own city of Cleveland, and it is in these stores that the Respondent found proof that Sears, Roebuck and Co. was infringing that patent, and it was only natural for the Respondent to bring its suit in the Circuit wherein Cleveland is located. Whether or not

the Respondent will be obliged, in order to protect its patent, to bring any other suit in the Sixth or any other Circuit, necessarily depends upon developments in the future. Respondent has no present intention except to do whatever is reasonably necessary to protect its patent rights. It is probably true, as alleged by the Petitioner, that a declaratory judgment suit against The Bishop and Babcock Manufacturing Company can be filed only in the Northern District of Ohio where the Company's office and plant are located, but almost every small company like The Bishop and Babcock Manufacturing Company can be sued for a declaratory judgment only in the Judicial District where it has its office and plant. Certainly the fact that a small company has an office and plant only in one place would not be considered ground for a writ of certiorari in the United States Supreme Court.

While we do not see any importance to the statement in Petitioner's motion that "Respondent sells heaters coming under the Mayo patent involved in suit between Petitioner and Respondent through The Bishop and Babcock Sales Corporation, a separate corporate entity and a corporation of New York", the fact is that this statement is untrue. Bishop and Babcock Sales Corporation is a very small subsidiary of Respondent which handles in New York and Chicago another product often sold for use in building construction in those localities, but does not sell or handle automobile heaters.

Before the present suit was brought by the Petitioner in the United States District Court for the Northern District of Ohio, the Mayo patent application was in litigation between the Petitioner and the Respondent in the United States Patent Office, the Board of Appeals of the United States Patent Office, and the United States Court of Customs and Patent Appeals for a period of almost six years, from 1937 to 1943, when the patent in suit was issued to

the Respondent as the result of the decision of the United States Court of Customs and Patent Appeals, which affirmed the decisions of the patent office tribunals. The Petitioner, on September 21, 1945, filed the present suit for declaratory judgment in the District Court, and a judgment in favor of the Respondent was entered by the District Court on June 10, 1947. The Petitioner appealed to the United States Circuit Court of Appeals for the Sixth Circuit, which, on May 3, 1948, affirmed the judgment of the District Court. A motion for rehearing was filed by the Petitioner in the Circuit Court of Appeals, and on June 2, 1948, the Circuit Court of Appeals reversed the judgment of the District Court as to one claim of the patent in suit, and otherwise again affirmed the judgment of the District Court. The Petitioner then filed in this Court its petition for a writ of certiorari, which was denied by this Court on October 11, 1948. Thereafter the Petitioner filed a petition for rehearing, and that petition for rehearing was denied by this Court on November 15, 1948. Now, about twelve years after the litigation between the Petitioner and the Respondent originally started in the Patent Office, the Petitioner files a motion for leave to file a second petition for rehearing, which alleges no new ground for the granting of a writ of certiorari and no new fact of consequence. We submit that the litigation between the Petitioner and the Respondent should now be finally ended by the denial by this Court of the Petitioner's motion for leave to file a second petition for rehearing.

Respectfully submitted,

JOHN A. DIENNER,

JOHN T. SCOTT,

*Counsel for Respondent.*

STATE OF OHIO,        }  
 CUYAHOGA COUNTY. } ss.

Edward L. Mayo, being first duly sworn, upon his oath deposes and says that he is an officer, to wit, the President, of Respondent, The Bishop and Babcock Manufacturing Company, an Ohio corporation with its office and place of business at Cleveland, Ohio; that affiant has read the above and foregoing Memorandum, knows the contents thereof and that the allegations of fact therein contained are true, as he verily believes.

EDWARD L. MAYO.

Sworn to before me by the said Edward L. Mayo and by him subscribed in my presence this 20th day of May, 1949.

ROBERT W. WHEELER,

(SEAL)

*Notary Public.*

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